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Supreme Court of the United States.

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Filed March 3, 1902.

CLINTON E. WORDEN & CO.,
Petitioner,

vs.

CALIFORNIA FIG SYRUP CO.,
Respondent.

ON CERTIORARI TO CIRCUIT COURT OF APPEALS, NINTH CIRCUIT.

BRIEF FOR RESPONDENT.

WARREN OLNEY,
For Respondent.

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Of Counsel.

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IN THE

Supreme Court of the United States.

CLINTON E. WORDEN & CO.,
Petitioner,

vs.

CALIFORNIA FIG SYRUP CO.,
Respondent.

BRIEF FOR RESPONDENT.

The question in this action is the application of the law relating to

UNFAIR COMPETITION.

Complainant in the Circuit Court, Appellee in the Circuit Court of Appeals and Respondent here, did not and does not claim that the name "Syrup of Figs" constitutes a trade-mark, but a trade name. The name is descriptive of the article originally put on the market, and, therefore, under many of the authorities, could not be treated as a trade-mark. Before, however, closing

this brief we shall show that under some of the latest authorities a descriptive name, when it has acquired a secondary meaning to the trade and with the public, may become and sometimes does come to be a trade-mark, in the full legal sense of the word.

But, for the purposes of our contention, it is not necessary to go further than to show the judgment of the court below was right upon the doctrine of UNFAIR COMPETITION.

That the name, "Syrup of Figs," was originally descriptive of the complainant's medicine is admitted by the appellant. (See pp. 10, 11, 12 of appellant's brief.) The record, as we shall presently show, proves, that, as originally compounded and put upon the market, the medicine was a true Syrup of Figs, that is, compounded principally of fig juice and senna, senna being the active medicinal agent.

The case at bar is entirely different from the cases cited by counsel for appellant from the Second and Sixth Circuits in two particulars, each so important, that it puts an entirely different phase upon the complainant's case.

They are:—

1. It was proven here that the name was a true and honest name when applied to the medicine.

There was no attempt to prove this fact in those cases.

2. The wording on the cartons and labels criticised in those cases was entirely eliminated long before petitioner flooded the market of the Pacific coast with its counterfeits.

The contention of the imitators in the Second and Sixth

circuits was that the complainant did not come into court with clean hands.

Upon that proposition we are not called upon in this case, to say that, upon the record presented to those courts, the decisions were either right or wrong.

The fraud committed upon the complainant and upon the public by Clinton E. Worden & Co., defendant in the court below, petitioner here, is admitted. But it is said: complainant is not entitled to any relief because it does not come into court with clean hands. This matter was fully presented on affidavits, on motion for injunction, and the court held, 86 Fed. Rep., 212, that complainant was not guilty of fraud and was entitled to relief. The case was then tried on its merits, the substantive defense still being the same. The decision of the court was again in favor of complainant, 95 Fed. Rep., 132. The defendant then appealed to the Circuit Court of Appeals, Ninth Circuit.

The opinion affirming the judgment is found in 102 Fed. Rep., 334.

The special attention of this court is called to the opinions of the courts below, especially to the first, in 86 Fed. Rep., p. 212, and the last, in 102 Fed. Rep., p. 334. In both decisions the courts based their rulings on the fact that complainant had eliminated the matters from its cartons objected to in the Second and Sixth Circuits. The courts, however, did not refer to the fact that the name was an honest one, upon the new evidence produced in this case.

For a complete understanding of our contention that plaintiff has a standing in court, and that the familiar

maxim of equity jurisprudence, upon which the petitioner relies, does not apply, it is necessary to state, from the record,

THE HISTORY OF THE CASE.

Confection of Senna has been a well-known laxative preparation for at least seventy years. Record, pp. 272, 273, 276, 277, 278, 281, 282 and 467.

This Confection of Senna was made by mixing senna with figs. Record, pp. 467, 272, 273, 277, and with other substances, but figs and senna seem to have been the principal ingredients.

There was also a Syrup of Senna (p. 272). The formula for Syrup of Senna is given in U. S. Pharmacopia. Thus it appears that Confection of Senna and Syrup of Senna are well-known preparations, officinally recognized by the medical profession and pharmacists. The Confection of Senna is a sort of paste.

In 1878–9 Richard E. Queen, an educated young pharmacist, was proprietor of a drug store in Reno, State of Nevada, and had given special attention to making original compounds of foods and medicines (p. 50).

It occurred to him that a liquid cathartic would sell better on the market than the prevailing kinds, and he made many experiments for the purpose of obtaining such a laxative (p. 51). He considered senna the best known base for a cathartic, but it must be so treated as to overcome the bitter taste and eliminate its griping effect, in order to make it popular. He succeeded in making a liquid preparation, which was in effect the same thing as the well-known Confection of Senna, and being composed principally of figs and senna, but over-

coming the bitter taste, and eliminating the griping quality. This preparation was a most excellent one, and was named by Mr. Queen "Syrup of Figs."

William Pinninger, an educated English pharmacist, was in partnership with Mr. Queen at the time the latter began to put his medicine on the market, and for a time (beginning in April or May, 1879, down to the end of 1880) did the manufacturing, pp. 446, 447. During this period that he manufactured the medicine he testified that figs were uniformly used, but the proportions used he had forgotten. But he says, on p. 467, on cross-examination, in speaking of the medicine:

"It was really a modification of the pharmaceutical "process in making Confection of Senna, which has a "world-wide reputation. All pharmacists know how "it is prepared. And this was just simply a modifica-"tion of that same thing as to the treatment of the "prunes, figs and tamarinds used in that compound."

The Complainant produced at the trial the grocer from whom Mr. Queen purchased the figs in what he considered large quantities. "I asked what they done with so many figs" p. 453, and was told they were used in the manufacture of "the medicine called the 'Syrup of "Figs.' "This conversation was with Mr. Queen. He "moved up just a few doors from me after the fire and "he used to come down there and buy these figs, and I "wanted to know what he done with so many of them, "and he told me that he was manufacturing this medi-"cine" (pp. 453-4).

If, what seemed to the witness large quantities of the fruit, seems to the court small (viz. "a dollar's worth or more at a time") it must be borne in mind, first, that

figs are very cheap on the Pacific Coast, and second, that this was in the early days of this medicine, and while the manufacture was on a very small scale.

The counsel for Clinton E. Worden & Co. admitted in the Circuit Court of Appeals the use of large quantities of figs by Mr. Queen, at first in the manufacture of his medicine, for he said, p. 32 of his brief in that court, "It would appear, however, that in 1878, Mr. Queen "was not fully convinced of this fact [that figs are not "really laxative] and was apparently of the opinion "that fig-juice, when used in substantial quantities in "his medicine, would add to its laxative properties, for "he began by using large quantities of fig-juice. The "soluable substance of the fig was dissolved in hot "water and put into the medicine in the shape of "fig-juice, the seeds and skin not being used at all "(Record 90). His first idea was to use large quanti-"ties, but he found that it was deleterious to the com-"pound, destroying its stability and causing it to "ferment. Therefore, he ceased using large quantities "of fig-juice and reduced it to the present small amount "(Record pp. 92, 93)." In the brief filed in this court the same admission is made at pp. 10, 11 and 12.

There is here an unequivocal admission of a fact that takes from Mr. Queen all appearance of perpetrating a fraud in giving his medicine the name "Syrup of Figs."

Having produced his compound, composed largely of senna and figs, that was in the main satisfactory, the question of a name to be given it came up.

His medicine was more in the nature of syrup of senna than anything else, just as the paste so well known to druggists was a confection of senna and so called. But

he could not use the name "Syrup of Senna" for that was a well known preparation, prepared in a particular way, with ingredients and their proportions prescribed. See U. S. Pharmacopia, title "Syrup of Senna," and Record p. 272.

Among pharmacists and physicians a formula set out in the U. S. Pharmacopia, to which a name has been given, becomes official, and a recognized article. The name means to the physician or druggist the precise article mentioned and described in the recognized official list of remedies.

While Mr. Queen's medicine was in the nature of "Syrup of Senna," yet it was not "Syrup of Senna" and was not made in accordance with the official formula of "Syrup of Senna." To have called his medicine "Syrup of Senna" would have been giving it a false name. It would have been stating to druggists and to the medical profession a falsehood.

We shall presently show that he made his medicine popular by getting the endorsement and recommendation of the medical profession and of druggists. It was solely through them that he placed the medicine originally upon the market.

If he had called his medicine "Syrup of Senna" physicians would have refused it recognition. He called it "Syrup of Figs," and the record shows that the medical profession have endorsed the remedy and have not objected to the name.

As he had freely used figs in the composition of his medicine, it was the most natural thing in the world for him to name it what he did. He used, for the

first time in the world, a syrup made from figs. He combined it with a medicinal agent and made it valuable. "There is no such preparation in pharmacy known as "Syrup of Figs" (p. 202).

Any one can make a real syrup of figs, but when made it is valueless. Any one can make a syrup of corn, but used alone it can have no virtue, except as food. The name of "Syrup of Figs" was unknown to the medical fraternity, to druggists and the world at large. Mr. Queen was absolutely and undoubtedly the first user of the name. This was proved beyond contradiction. It was also proved that while the term is descriptive of what any one can make with figs, hot water and sugar, yet it has come to have a secondary meaning. It means to physicians, druggists and the public at large, Mr. Queen's composition and nothing else.

Returning to the circumstances surrounding this naming of the child of his invention, is there anything fraudulent in his calling it "Syrup of Figs?" It was a true syrup of figs combined with senna and other plants. There is no doubt he intended, as claimed by counsel for defendant in the court below, to make the name descriptive.

But that is not a fraud. He intended to make the name attract the attention of the public, as something new and original.

But that was no fraud. It is only what men have done from time immemorial, and no censor of morals has yet had the hardihood to declare it a crime.

Mr. Queen called his new medicine "Syrup of Figs" as he had a perfect right to do. Presently we shall call

attention to the fact that the medical profession has never found fault with the name, but has endorsed the medicine beyond anything ever known in the history of proprietary remedies. They prescribe it by that name.

The learned counsel for Clinton E. Worden & Co. has stated the result of the testimony correctly in the extract already quoted, when he says: "His (Queen's) first idea was to use large quantities of this fig-juice, and he did use large quantities, but that he found it was deleterious to the compound, destroying its stability and causing it to ferment. Therefore, he ceased using large quantities of fig-juice and reduced it to the present small amount."

See also Record p. 93.

But this reduction was after the name had been given in good faith, and after the demand for it required the manufacture in large quantities.

If the medicine could always be shortly used after its manufacture, it might be made as in the original formula, but experience in the manufacture of large quantities, to be kept for a long time, and for export, has shown that too much of the fig-juice endangers the proper preservation of the medicine and its uniform action.

Mr. Queen testified that he continued to make changes and improvements in the medicine down to 1885–1886 (p. 81).

Since that time the complainant company uses the soluable parts of ten pounds of figs to one hundred gallons of the medicine, or a little less than one per cent. (pp. 55, 91, 97, 250). There is no justification in the

record for counsel's contention that the amount of fig juice is less than one-tenth of one per cent. (see p. 58 *et seq.* of Appellant's Brief).

No doubt the average man is unable to detect, from such a small percentage, the taste of fig in the medicine. But Dr. Winslow Anderson (see p. 172), a graduate of the University of California and of the Royal College of London, and Dean of the San Francisco College of Physicians, was able to detect it distinctly by the taste (see p. 479).

This gentleman gave quite an exhibition of his ability to analyze medicines by the taste (pp. 477–480).

But that it has a positive beneficial effect in the production of the agreeable taste of the medicine cannot be doubted. The composition is noted for its pleasant taste. It is one reason why it is so popular.

The ingredients in its composition have been selected and proportioned by an artist in his business, and when he declares that the fig juice does tend to produce the result he has labored for, and attained, he is entitled to full credit (pp. 102, 103).

Introduction of the Medicine to the Public.

Mr. Queen having, as he believed, made a really beneficial medicine out of senna and fig juice, together with carminatives, took a method of introducing it to the public quite different from the ordinary methods of men pushing patent medicines. His method was to visit physicians, tell them the ingredients and get them to try it. They did try it, with the result that they recommended it to their patients (pp. 52, 53).

After the reputation of his medicine had spread from Reno to the neighboring towns in Nevada and California, he came to San Francisco, having first incorporated the Plaintiff Company. This was in 1883. In 1885 he went to Louisville, Ky., and established a branch office, but the business was still very small, "and in the year " 1887 we commenced to place advertisements in medical " journals stating, for the information of physicians, the " composition and active ingredients of the preparation, " and, in that same year I commenced, acting as Manager " of Complainant, to have the representatives of the " California Fig Syrup Company visit physicians at med- " ical conventions, and in their offices, with instructions " to give samples of the remedy to physicians, to request " them to try it in their practice, and to state to them " the active ingredients of the preparation, that a small " quantity of figs were used simply to promote a pleasant " taste, and to give them such other information as they " might desire in regard to the manufacture and sale of " the article. . . . We did make a special effort [to " attract the notice and recommendation of physicians] be- " lieving that it would be greatly to our advantage to se- " cure the approval and recommendation of physicians. " We have continuously, down to the present time, adver- " tised the facts in leading medical journals very exten- " sively and continuously, and spent many thousands of " dollars to inform physicians that the active principals, " the active laxative parts of the preparation, are obtained " from senna, combined with aromatic carminatives, and " that other substances are used, such as sugar, water " and a small quantity of fig-juice. It resulted in a

" very large recognition and acceptance on the part of " the medical profession, of Complainant's preparation, " and in the recommending and prescribing the same " and a large increase in our sales" (pp. 55, 56).

There is no profession or calling so rigorous in the application of ethical rules to the practice of their profession, as that of physicians. Some of these rules seem to us artificial, and not based upon a wide or general apprehension of the world, or of men, but the strict adherence to them of what are called the regular part of the profession is well-known. One of these rules is not to patronize patent medicines or quack nostrums of any kind. They go so far, that medical journals, in good standing, will not receive or publish advertisements of medicines except in a few cases that have been passed upon by a board of physicians, and the medicine pronounced to be an " ethical remedy."

How do they treat the remedy known as Syrup of Figs?

Dr. Joseph M. Matthews, of Louisville, Kentucky, is, or was, the President of the American Medical Association, the great national organization of what are called the "regular" physicians (p. 156.) He published, some years ago, a book on diseases of the rectum (p. 61) pronounced by competent physicians "the best-known book on the subject" of which it treats (pp. 173, 158). In this book, at p. 279, he recommends the use of "Syrup of Figs" in certain cases, saying among other things, "Children especially can take this medicine easily. Its " purgative action is obtained from the use of senna" (p. 61).

Compare the medicine specially recommended for children by the President of the American Medical Association, with the imitation placed on the market by Clinton E. Worden & Co., with its twenty-five to thirty-two per cent. of alcohol and a quantity of henbane. See Petitioner's Exhibit 6, opposite p. 624, and p. 472.

The "Journal of the American Medical Association" is the national official organ of the Physicians of America in regular standing, p. 157. Before advertisements are admitted to the columns of this journal, they must be passed upon by "a council composed of prominent members" of the Association, and when an advertisement of a remedy is admitted by this board, it is considered an "ethical remedy," pp. 488, 484. This journal has from the start published the advertisement of the medicine of Complainant, respondent here.

Again, some of the best known and most reputable physicians were willing to go on the stand and testify to the excellence of the medicine known as Fig Syrup; that they used it themselves in their own families and prescribed it for patients. They were Dr. Winslow Anderson, Dean of the College of Physicians and Editor of Pacific Medical Journal; Dr. Gerald Fitzgibbon, a member of the San Francisco Board of Health; Dr. A. P. Woodward, President of the San Francisco Medical Society; Dr. D. A. Hodgehead, Professor of Obstetrics and Diseases of Children in the College of Physicians, and Dr. W. F. McNutt, than whom there is no better known physician, or who stands higher in his profession on the Pacific Slope. All these physicians recommended in high terms this remedy with which they had been acquainted for years.

It has never occurred to them that calling this medicine "Syrup of Figs" was a fraud upon the public. The testimony of Mr. Henry Michaels, a leading wholesale druggist of California, shows how the drug trade regard the complainant's medicine and also how they regard the use of the term "Syrup of Figs." His testimony begins at p. 205. At bottom of p. 215 is the following question:

"If you were to hear the word 'Syrup' applied to a "new vegetable or fruit, to which it had never been "applied before, what would that indicate?

A. "Well, in medicine, I would take it to indicate a "compound. It is common practice in putting up pro- "prietary medicines to invent or take names, catchy "phrases, as we call them. They use this in that way. "Some of them coin words altogether."

Q. "Is it common practice to employ a phrase as "indicating a compound which incorrectly described the "contents of the compound?"

A. "Well, it does not imply that exactly, but it does "not convey, to the dealer's mind at least, the idea that "that compound is solely composed of that article. "Now, you take sarsaparilla. That is one of the com- "monest articles named in the drug trade, but that is "only an agent. It is the most unimportant part of the "whole compound."

It should be borne in mind that Mr. Queen is a druggist, and before adjudging him guilty of fraud and refusing him redress for a most grievous wrong, it would be well to place one's self in a position to look at the case from his point of view. Neither doctors nor druggists have ever thought him in the wrong in his method

of advertising his medicine. They have always been unconscious of any sin having been committed by the complainant or Mr. Queen.

No doubt lawyers and judges know more, especially of ethics, than any other class in the community, but we think the suggestion not out of place that, in a matter in which the medical profession are especially interested, and involving a question of ethics in the matter of advertising and prescribing a medicine, that the profession and the medicine are both entitled the benefit of a reasonable doubt before convicting the medicine of having a fraudulent name, or the profession of willfully patronizing or recommending a fraud. They should not be condemned unless clearly guilty. The court would not adjudge that a matter peculiarly within the province of the clergy was a fraud, when the clergy did not think so, unless the case was beyond all doubt. The court would certainly hesitate to declare a clergyman's act fraudulent, if his conduct was common to all his brethren. We do not claim that, in a clear case, the court should refuse to condemn where the ethical standards of another profession are involved, but what we claim is, that a reasonable regard for the fallibility of human judgments should make the court very slow to condemn, in the medical profession, a line of action that seems to that profession unobjectional. It must not be overlooked that the approval of the medicine by physicians was obtained while the medicine was enclosed in the cartons to which the Courts in Second and Sixth Circuits objected.

Having shown how and why the medicine was named "Syrup of Figs," and that it met with great favor from physicians and the public, we proceed in our history to the commission of the only act by complainant that has ever been criticised, save and except the criticism on the name.

Before going further, however, we desire to say that none of the material facts hereinbefore set out relating to the naming of the article were ever before presented to any court that rendered an adverse decision to complainant. This we shall enlarge upon when we come to speak of the adverse decisions rendered by certain courts condemning the actions of this repondent and refusing it relief.

After the medicine was named, and down to the year 1889, no reference was made on the carton enclosing the bottle, nor on the label on the bottle itself, to figs (see p. 83, *et seq.*). The carton in which the bottle was enclosed was in all other respects substantially similar to the one that has been in use since July, 1896, and which is found opposite page 634 of the record, where it is marked "Complainant's Exhibit A." By looking at this exhibit it will be seen that the carton has on it these words near the bottom: "The juice of the figs in the "combination is to promote the pleasant taste."

With the exception of these words and the words on the side making substantially a similar reference to juice of figs, the carton in use at the time this suit was brought and since July, 1896, was the carton in use up to May, 1889 (pp. 83, 84, 85). Counsel for respondent say (pp. 35, 45, 46 of brief) that the original label was the

same as that in use at the time of the adverse decision in the Eastern Courts. The same statement was made in the court below in briefs and their attention called to its incorrectness.

In May, 1889, complainant inserted in the label placed on the bottle the words "California Liquid Fruit Remedy," but removed them in May, 1894, just three years before Clinton E. Worden & Co. put their immitation on the market. Counsel for petitioner (p. 54) say that this label is not in controversy in this action. Upon that proposition we are agreed.

The outside wrapper or carton down to May, 1889, had nothing on it relating to figs. But in that year a change was made, and on the carton or outside wrapper appear these words in large capitals: "Syrup of Figs " presents in the most elegant form the laxative and " nutritious juice of the figs of California combined with " the medical virtues of plants known to be most bene- " ficial to the human system, forming an agreeable and " pleasant laxative," etc., pp. 84, 85.

This wrapper was discarded in July, 1896, one year before this action was brought.

And, therefore, like the label on the bottle, *is not now the carton in controversy?*

A *fac simile* of this old wrapper or carton is set out opposite p. 634 and marked there "Complainant's Exhibit B." That is a mistake. This wrapper was not offered in evidence by the complainant. Complainant's exibit "B" is the bottle itself, see p. 18, but is not copied into the record, for the reason that, by order of the Court, the original was sent to the Circuit Court of

Appeals, see pp. 592, 593. This old wrapper, found opposite p. 634, is petitioner's exhibit 16. See p. 503.

Petitioner's Exhibit 16, marked by mistake Complainant's Exhibit "B" and opposite p. 634, is the carton the Complainant used from May, 1889, to July, 1896. It is the whole head and front of Complainant's offending. It hath this extent, no more, that Complainant, during these years placed on its carton these words: "Syrup of "Figs presents in the most acceptable form the laxative "and nutritious juice of the figs of California, combined "with the medicinal virtues of plants known to be bene-"ficial," etc.

As the medicine was originally prepared, the statement was exactly true. Upon the record as made in this case, there could not be a fairer statement of the ingredients of the medicine while it was being manufactured and sold in small quantities.

But does it state a falsehood about the medicine that was afterwards manufactured and sold in large quantities, but had as one of its ingredients, however small, the laxative and nutritious juice of the fig, combined with the medicinal virtues of other plants? It certainly does not.

There is no claim made that the medicinal qualities of the preparation comes from figs. That quality is expressly stated to come from other plants.

We come now to the decisions rendered in the Second and Sixth Circuits.

The preparation had become immensely popular, for when the medical profession turned to it as a gentle laxative, of course, with proper advertising, the public

would do likewise. Hence unscrupulous druggists put on the market imitations, and, when sued, defended on the ground that the complainant's name and cartons were fraudulent. It has always been known, for complainant had taken great pains that druggists and medical men should know, that the medicinal virtues of the preparation came from senna. Hence the pirates had a plausible defense to their hand.

Now, here was where complainant made a mistake. Acting under advice of able counsel, it claimed the name "Syrup of Figs" to be a technical *trade-mark*, when all that it was necessary to claim was that it constituted a *trade-name*. But it is not the first time, nor will it be the last, that client and distinguished counsel have made, and will make, what appears to others, a great mistake in what is called the "Theory" of a case.

Able counsel in the Second and Sixth Circuits pressed injunction suits against infringers on the theory that complainant had a trade-mark in the name, and that the statement on the cartons and bottles was immaterial.

He did not address himself to showing that the name "Syrup of Figs" came to be honestly and properly applied to the product as largely descriptive of the ingredients of the medicine. He was so afraid of ruining his case as a case of trade-mark, by showing that it was descriptive, that he did not prove what was proved in the case now at bar, viz.: That figs were at the time the name was given an important part of the composition.

That the name was descriptive, was the rock over which he and his client stumbled.

The result was that upon the case, as presented in the Second and Sixth Circuits, the courts denied complainant any relief. We are not prepared to say that upon the cases, as presented, those courts were wrong.

In California, the complainant did not claim in the suits it brought, that Syrup of Figs was a trade-mark, but did claim unfair competition.

Its counsel addressed himself specially to showing that the complainant's hands were not foul. The first case there came up upon motion for injunction before a distinguished member of this court, and was quickly disposed of upon the showing made by affidavits. The defendant took an appeal from the order granting an injunction, and in the Appellate Court the same effort was made, and successfully made, to show that plaintiff had a standing in court. In the decision rendered by the Circuit Court of Appeals (54 Fed. Rep., 175), the court went even further than counsel had contended for, and held there was a technical trade-mark.

There is no necessity for us to contend, that in so holding the Court was right. But we do contend that it was right, clearly and unmistakably right, in refusing to throw the complainant out of Court and enjoining the use of the name. Those were the questions to which counsel on both sides addressed themselves. They were the questions they pressed *pro* and *con* with their utmost strength before the Judge of the Court below on motion for an injunction.

This Court has now the facts, and presently we shall

cite the decisions that justified the Courts in the Ninth Circuit in refusing to turn the complainant out by the shoulders, when a most grievous wrong was being perpetrated upon it. These decisions will show that though complainant did at that time use on its carton the phrase that "Syrup of Figs presents in the most "acceptable form the laxative and nutritious juice of the "figs of California, combined with the medicinal virtue "of plants," and did use on the inside label the phrase "California Liquid Fruit Remedy," yet complainant is not beyond the protection of the law, and may not be robbed with impunity.

But before citing these authorities we desire to call attention to the petitioner here (one of the defendants in the Court below).

Clinton E. Worden testifies that before starting in business on his own account (page 400 et seq.) he was in the employ of Frederick Stearns & Co. in California as the agent of that corporation. The business of Frederick Stearns & Co. appeared from the testimony of Henry Michaels (pages 216–217) to be that of manufacturing what is called "non-secret" medicines. The witness says (top of page 217): "Non-secret medicines are under-"stood by the trade to be such articles as will come pretty "near in appearance and quality to well-known patent "medicines for the purpose of selling in their place."

"Q. Practically, then, what is known in the trade as "a manufacturer of non-secret medicines is one who "manufactures articles as nearly like the proprietary or "patent medicines as possible in order to take the place "of these medicines in the trade?

" A. Yes.

" Q. That is the understanding in the trade?

" A. That is the understanding, yes."

(See also the statement of facts in opinion of the Circuit Court of Appeals in the *Stearns case*, 73 Fed., at p. 814). It will thus be seen that the business training of Clinton E. Worden fitted him for the work he admits to have done in California. He started a manufactory of medicines in California forming the defendant corporation. The complainant on the trial put two of the defendants upon the stand as witnesses, viz.: J. A. Bright and Truman F. Bacon. Mr. Bright's testimony commences at page 513, and we respectfully ask the Court to read the testimony of this witness through, and likewise the testimony of Mr. Bacon, which commences at page 537. The witness Bright testified (page 516) that the defendant Clinton E. Warden & Co. through its agent had been in the habit of coming to him soliciting him to purchase "non-secrets," and among others solicited him to purchase "Syrup of Figs." Mr. Worden himself testifies (page 402) in answer to the questions asked by his counsel as follows:—

" Q. When did you commence to manufacture an " article called Syrup of Figs?

" A. And put it on the market as Syrup of Figs?

" Q. Yes.

" A. After the suit of the *California Fig Syrup Co.* " v. *Frederick Stearns & Co.* had been decided by the U. S. Circuit Court of Appeals."

Before beginning the manufacture of his compound he had complainant's medicine analyzed to see if he could

find out what it was made of (pp. 330, 331). How suggestive this is of the intent he had in view!

Mr. Worden testified at another place that he learned of this decision in May, 1896. He did not put his medicine upon the market until about the first of May, 1897. If he had done so the complainant would have known it at once. It was not until the 7th of May, 1897 (page 69) that his medicine was found on the market. This suit was brought on the first of June, 1897. *The bill of complaint alleges* (p. 23) *and the answer admits* (pp. 39–40) that the defendant Clinton E. Worden & Co. puts up a preparation in bottles and packages marked with the words "Syrup of Figs," "and has stated and declared on "the outside carton or paper box containing said bottles "words importing the meaning and statement that the "same is prepared and sold by a Fig Syrup Company. "On some bottles the statement is made by the said de- "fendant to the effect that said preparation is made by "the 'San Diego Fig Syrup Co., San Francisco, Cal.;' on "other bottles the statement is made to the effect that said "preparation or compound is made by the 'Fig Syrup "Company, San Francisco, Cal.;' on other bottles the "statement is made that said preparation is manufactured "by the 'San Francisco Fig Syrup Co., San Francisco, "Cal.' On other bottles the statement is made to the "effect that the compound is prepared by the 'New "York Fig Syrup Co., New York City, N. Y.;' and "again on other bottles the statement is made that it "is prepared by 'Yetiva Drug Co., Louisville, Ken- "tucky;' and again on other bottles said defendant "makes the statement that the preparation is manu-

" factured by the 'Laxative Fig Syrup Company, New " York City, N. Y.'" These are all fictitious names.

Of course there could be only one purpose on the part of the petitioner here in placing such statements upon the cartons enclosing its compound, and that was to deceive unwary customers into supposing that they are purchasing the genuine article made by the complainant.

Copies of Exhibits "D," "I" and "U," are on the sheet opposite p. 634, but for some reason unknown to respondent here Exhibits "E," "F," "G" and "H," have not been supplied to this Court. But see p. 593, showing they properly belong to the Record. They only intensify the fraud shown in the exhibits copied at p. 634.

Those given in printed record show how the defendant, Clinton E. Worden & Co., has simulated the package of complainant, taken the name "Syrup of Figs," and declared on the packages that the medicine is manufactured by a Fig Syrup Company.

Now, if the Court will turn to the testimony of Mr. Bright and Mr. Bacon, hereinbefore referred to, it will learn, from the positive testimony of the witnesses, the purposes for which these names were placed on the packages and how they came to be placed there. The Court will learn that Clinton E. Worden & Co. sent solicitors around to druggists telling them that since the decision of the Stearns case they could safely sell an imitative medicine under the name "Syrup of Figs," and offering to print on the package statements showing that the medicine was manufactured by a Fig Syrup Company.

The Court will see that upon these statements these

two defendants were induced to purchase from Clinton E. Worden & Co. The testimony of these two witnesses is rather entertaining as well as instructive. For example, the testimony of Mr. Bacon shows how he came, at the solicitation of Clinton E. Worden & Co., to purchase some of the imitative preparation, and how the name "New York Fig Syrup Company" came to be upon the medicine that he was offering for sale in his drug store, and then, on the cross-examination, at page 544, he states that he put the defendant's imitation on his counters and sold some of it, in answer to calls, for Syrup of Figs.

"Q. 42. How did people call for it?

"A. Syrup of Figs, and I would sell that whenever " I could."

On re-direct examination (548), he says that when the term "Syrup of Figs" or "Fig Syrup" is used in the trade it is understood to refer to the complainant's preparation, that if an order is made for "Syrup of Figs" or "Fig Syrup," plaintiff's medicine is meant; that the reputation of this medicine is good.

"Q. 6. Therefore, if a medicine bears the name " 'Syrup of Figs,' it is more likely to sell, is it not, just " for that reason?

" A. Certainly; the advertising of it has created a " demand for it.

" Q. 7. And if any other medicine is sold under the " name, the purchaser, the people who want laxative " medicines, would be induced to buy just because of the " good reputation of the complainant's medicine?

" A. Yes, sir.

"Q. 10. Now, when customers call for 'Syrup of "Figs,' if you gave them the medicine that you bought "from Mr. Worden they would take it, would they?

"A. They would."

Upon the foregoing state of facts ought the plaintiff to be turned out of Court?

It would be most unjust to do so. It was that carton and label, first used in 1889, and thrown out in 1896, that afforded any ground for criticising complainant. It has been shown in this case that the name itself was proper and justifiable. That carton and label were not untrue, but upon the facts as shown in the Sixth and Second circuits, they appeared to be untrue. Complainant immediately told all the world (see Exhibits C, C1 and C2) as it had previously told physicians and druggists the facts as they are. The public has not been defrauded by complainant. It is the petitioner here, and dishonest druggists who are attempting to defraud the public. They ask this court to assist in the fraud. For if the judgment of the court below is reversed, every dishonest druggist will immediately put up a medicine and call it Syrup of Figs, selling it at a small price. Honest druggists will in self defense do the same thing or else lose trade.

It has been found by actual experience that if one druggist in a town puts out an immitation the most of the others follow suit, and when remonstrated with justify their conduct by the plea of self defense.

If the judgment is affirmed no harm will come to any

human being. If it is reversed, the markets will be flooded with all kinds of nostrums under the name of Syrup of Figs, complainant will be ruined and the public will be injured.

There ought to be another maxim of the law to the effect that a party appealing from a judgment rendered against him shall be turned out of the Appellate Court when the only effect of reversing the judgment will be to enable him to commit a fraud.

There has been so much pirating of trade-marks and trade-names that hardly a volume of the Federal Reporter comes out, in these days, without containing the reports of cases of attempted stealing of business by unscrupulous parties. One of the favorite defenses is that plaintiff is himself guilty of some breach of ethics in advertising his business.

We do not question the maxim that a plaintiff must come into a court of equity with clean hands, but of late so many parties, trying to steal the business of others, have invoked this maxim, that there is danger of its becoming a defense for fraud.

An examination of the recent cases shows that courts are waking up to this defense of piracy and are beating it.

The rule now seems to be as follows:

WHERE A MAN HAS AN ESTABLISHED BUSINESS WHICH HE IS SEEKING TO PROTECT FROM UNFAIR COMPETITION, HE WILL BE GIVEN RELIEF IF HE CAN MAKE ANY REASONABLE EXPLANATION OF STATEMENTS CLAIMED TO BE FALSE.

In other words, the Complainant is entitled to the benefit of every reasonable doubt. He shall not be con-

victed of fraud at the solicitation of one trying to rob him, unless the case against him is clear.

Applying such a rule to the respondent here, and where is the case against it!

Let us examine the late cases to see if the rule is not as stated.

Cochrane v. *Macnish*, 1896 App. Cases, 225:

Plaintiff was a manufacturer and seller of mineral and aerated waters. He registered, in England, a trade-mark for soda water, having the words "Club Soda" as its prominent and distinguishing feature. The plaintiff's soda water came to have a large sale under this name, so that the term "Club Soda" came to mean the plaintiff's water, and nothing else. The plaintiff shipped large quantities to Jamaica. The defendants began to sell soda water there as "Club Soda," and the plaintiff brought this action to enjoin them. The defendants set up that their article was so packed that no confusion of their article with the plaintiff's could occur, and also that the plaintiff was not entitled to relief by reason of false and misleading statements in his trade-mark. The trade-mark had on the margin the words "Manufactured in Ireland by H. M. Royal Letters Patent." There was no patent covering the manufacture, and this statement was claimed to be false and misleading. In the trial Court the Judge held that the first defense was made out. In the Supreme Court of Jamaica the majority of the Court held that the first defense was not made out, but that the plaintiff was not entitled to relief because of the statement mentioned on the label. On appeal to the Privy Council this was reversed. The Court held that the

defendant was not entitled to use the words "Club Soda." The question was whether the plaintiff had disentitled himself to relief. The question turns on the meaning of the words on the label. The lower Court found that they meant that the article was protected by an existing patent, and this was strongly urged by respondent's counsel. Plaintiff's explanation was that, with some unimportant exceptions, he used patented machinery in manufacturing the soda. "Considering that it is common ground, that in the manufacture of soda water there is no secret, and frequently no soda, and that all that is required is care and cleanliness; that does not seem an unreasonable or unnatural explanation. There is no suggestion to be found in the evidence tending to throw doubt on that explanation or to show that anybody has been or could be misled by words on which so much labor and attention has been spent in argument and to which apparently little or no importance is attached elsewhere. The appellant's trade is an honest trade and their lordships are not prepared to hold that, by reason of such words not designed to mislead and at most equivocal, the appellant has been guilty of a misrepresentation which disentitles him to relief."

Insurance Oil Co. v. *Scott*, 33 La. Ann., 946:

The plaintiff was selling an oil, calling it "Insurance Oil," and brought suit to enjoin the defendant from doing the same thing. Plaintiff's trade-mark had on it the word "patented." The plaintiff's oil had not been patented but his trade-mark had been registered in the Patent Office. Upon the falsity of the statement in the

word "patented" the defendant relied as disentitling the plaintiff to relief. The Court lays down the proposition very emphatically that in order that the plaintiff be so disentitled it must appear that the label was used for the purpose of deceiving the public, and that if a fraudulent intention does not exist and the use of the word may be explained in *any reasonable sense* consistent with truth and honesty, the party will not be prejudiced. This would seem the true statement of the rule applicable to all of these cases.

Siegert v. *Findlater*, 7 Chanc. Div. 801.

Suit by the proprietors of bitters known as "Angostura Bitters," to enjoin an imitation of their bottles and labels. The heading of the label read "Aromatic Bitters, or Angostura Bitters, prepared by Dr. Siegert at Angostura, now Port of Spain, Trinidad." At the time this label was used, however, Dr. Siegert had been dead for some years and he had in fact never lived at the Port of Spain. Furthermore, the label stated that it bore the complainant's signature, when in fact the signature was that of Dr. Siegert. Upon these facts, the defendant claimed that the plaintiff was disentitled to relief. It appeared, however, that the bitters known as Angostura Bitters had been previously made by Dr. Siegert at Angostura, and had acquired an extensive reputation; that at his death, the plaintiffs, who were his heirs, succeeded to his business and continued to carry it on, using the same formula and manufacturing the same article. Subsequently, they removed to the Port of Spain. Upon these facts, Justice Fry said that he could not see anything in the wrapper that amounted to

a fraudulent misrepresentation by reason of which the plaintiff should be denied relief. Furthermore, it appeared that the label containing the so-called misrepresentations was adopted since the beginning of the suit, and Justice Fry said that it was therefore collateral to the action and not material. (For a decision to the contrary upon exactly the same facts, see *Siegert* v. *Abbott*, 61 Md., 276; 48 Am. Rep., 101, severely criticized in Brown on Trade-marks, pages 83 to 85.

Fetridge v. *Merchant*, 4 Abbott's Pr., 156.

Facts the same as those of *Fetridge* v. *Wells*, the Extract of a Thousand Flowers case. Judge Hoffman said: "I have always considered that upon this branch of the subject the conduct of the defendant has a material influence. Has he deliberately, without any previous connection with the particular business, but simply to break in upon the trade and profit by the notoriety obtained by another, adopted his emblems and appellations? If he has, then in my view the question should be judged of solely as between the immediate parties and the public should be left to its own guardianship."

Ford v. *Foster*, 7 Chanc. App., 611.

The plaintiff was the maker of shirts of a particular sort, which he called "Eureka Shirts." On each shirt he had stamped the name "The Eureka." Action to enjoin the defendant from using that name. The plaintiff had previously represented himself in advertisements as a patentee of the shirt, which he was not. *This misrepresentation had ceased at the time of the suit. It was relied upon, however, as a defense.* The court held that if the plaintiff would have any right at law against the

defendant he would be entitled to have that legal right protected in equity. And the cases of *Piddington* v. *How*. *Perry* v. *Truefitt*, and *Flavvel* v. *Harrison* were referred to as holding merely that the matter should stand over until the plaintiff could establish his legal right by an action at law. If the trade-mark in itself were fraudulent, no relief at law upon the basis of that trade-mark could be afforded; but in this case the misrepresentation was collateral to the trade-mark and not a part of it. The plaintiff, in our opinion, had an action at law. The court held that it must therefore grant an injunction "because it cannot be right that if the plaintiff is allowed to maintain his action that he should be obliged to bring perpetual actions at law instead of having his action in this court."

Bardou v. *Lacroix*, 27 Annales, 214. Brown on Trade-marks, p. 83.

The plaintiffs were makers of cigarette paper and had given to their product the name of papier goudron (tar paper), which had acquired great popularity. They brought suit to enjoin the defendants from imitating their wares. In the lower court the defendant was victorious, on the ground that the plaintiff was disentitled to redress by reason of false misrepresentation, as the paper did not contain a particle of tar. The French Court of Cassation, however, reversed the ruling of the lower court.

Meriden, etc., Co. v. *Parker*, 39 Conn., 450; 12 Am. Rep., 401:

Certain brothers by the name of Rogers acquired a high reputation as manufacturers of silver forks and spoons. They sold the right to their trade-mark, which

contained their name, Rogers Brothers, to the plaintiff, the Rogers Brothers agreeing, however, to give their personal superintendence to the manufacture of the plaintiff's goods. The plaintiff sought to enjoin the defendants from imitating this trade-mark. The defense was made *inter alia* that the trade-mark falsely represented Rogers Brothers to be the manufacturers instead of the plaintiff. It appeared that while the trade knew that the plaintiff was the manufacturer of the goods stamped with the trade-mark, the consumers supposed that Rogers Bros. were in fact the manufacturers. The Court held: "The principle of law underlying this "objection is fully conceded, and that is that courts of "equity will not protect a trade-mark which deceives "the public. We do not suppose, however, that that "deception need be of such a character as to work a "positive injury to purchasers, *nor, on the other hand,* "*that every erroneous impression which the public, or a* "*portion of the public, may receive, will be sufficient to* "*destroy the validity of the trade-mark.*" In this case the goods of the plaintiff are manufactured under the superintendence of Rogers Brothers. The representation of the trade-mark was, therefore, in an important sense, true. All the public cared to know was that the goods were the production of their skill and experience. The fact that the plaintiff furnished the capital, machinery, and conducted the business, is entitled to little weight, although in another sense they were the manufacturers of the goods. There is no misrepresentation such as is contemplated by the cases refusing relief to a false trade-mark.

Simons Medicine Co. v. *Mansfield Drug Co.*, 23 S. W., 169:

One A. Q. Simons, a farmer in Georgia, came into the possession of a secret formula for the making of a valuable liver medicine. In 1840 he and his son, M. A. Simons, entered upon a plan of putting it on the market. Shortly afterwards they separated, agreeing that each might go on making and selling the medicine. M. A. began to advertise extensively, selling it as Dr. Simon's Liver Medicine and Dr. M. A. Simon's Liver Medicine. The father transferred his right to another son, C. A., who, in turn, sold it to the defendants. M. A. sold his right to the plaintiff. Immediately a bitter rivalry sprang up and this action was brought by the plaintiff to enjoin the defendants from imitating the plaintiff's name and label. One of the defenses was that the complainant did not have clean hands—(*a*) because, in a circular scattered broadcast, it was stated that M. A. was the discoverer; (*b*) the plaintiff's packages contained the following: "Trade-mark, registered, consisting of name, "picture and autograph, November 11, 1843," when in fact the trade-mark of the plaintiff had not been registered at that time; (*c*) each package contained the statement, "This is the only original and genuine Simon's "Liver Medicine," when, as above appears, there was other genuine medicine on the market. The court quotes the statement of the rule from Brown on Trade-marks, Sections 71 and 87, to the effect that there must be a fraudulent intent to mislead in order to disentitle the plaintiff to relief and says that the statement that M. A. Simons was the original discoverer would have undoubt-

edly disentitled the plaintiff to relief but for the fact that this statement was made only in one circular and had not been made since, although it was true that this circular was widely circulated. As to the statement on the packages about the trade-mark, the court says: "But "we do not think it was intended thereby to mislead the "public as to any material matter, or that it did so mis-"lead the public." In the controversy between the plaintiff and the defendants, the plaintiff wished to show his early connection with the medicine. He had registered on November 11, 1843, a book called "Dr. Simons' "Vegetable Liver Medicine, prepared solely by A. Q. "Simons and Son, Walker County, Georgia." The statement on the packages was intended to call attention to the cardinal fact of Dr. M. A. Simons' early connection with the medicine as a proprietor, and in this sense the label states the truth. The statement in other respects is wholly immaterial, absurd and inocuous, because there was no law for registering trade-marks in 1843. As to the statement that the plaintiff's medicine was the only genuine medicine, this also was not true, but the statement was made by M. A. Simons with no intent to deceive, as it clearly appeared that he believed the defendant did not have the proper formula and had throughout consistently contended so. Furthermore, he attached the greatest importance to the word "medicine," which he had originally used. His statement was true in the sense that it continued the ancient name with the ancient formula. The plaintiff was accordingly granted relief.

Smith v. *Sixbury*, 25 Hun., 232 :

In this case, the name "Magnetic Balm" was held to be a valid trade-mark for a medicine, although it contained neither magnetism nor electricity. The Court held that it did not contain any fraudulent suggestion.

Tarant Co. v. *Hoff*, 76 Fed., 957.

The plaintiff was the proprietor of Johann Hoff's Malt Extract and brought suit to enjoin the defendants from imitating its labels. "Nor do we find that com-
" plainant is disentitled to relief in equity by reason of
" any false representations in its own labels as to the
" place of origin of the extract itself. Some of the
" statements they contain, survivals from the older labels,
" are not now strictly accurate, notably the words 'Moritz
" Fisher, Sole Agent for U. S. of America,' but they
" are immaterial. The labels certainly contain no state-
" ment that the extract is made in Germany, while the
" record shows that the complainant has been to no
" inconsiderable expense to advertise its new industry
" of manufacturing the Johann Hoff's Malt Extract in this
" country. The criticism that its label states that there
" is such a factory and brewery in New York, when
" complainant is at Newark, is too trivial to merit dis-
" cussion."

Conrad v. *The Joseph Uhrig Brewing Co.*, 8 Mo. Ap., 277 :

The plaintiff was the seller of Budweiser lager beer and brought suit to enjoin the defendant from selling beer under that name. The defendant set up that the plaintiff was not enlitled to relief because the name Bud-

weiser indicated beer made in Budweis, when in fact it was made in St. Louis, and further, that the labels stated that the beer was made of the best imported hops and barley, which was not true. To this the court said: "It "is contended that the law can afford no protection to "plaintiff because his so-called trade-mark or label was "in itself a misrepresentation. This beer, it is said, was "not Budweiser beer. That it was not Budweiser beer "in the sense that it was not made in Budweis is true, "but it does not appear that it was held out to the "public either as actually made in Budweis or as a "foreign article. The statement on the label explains "that it was not made at Budweis, but by the Budweiser "process. Whether there was anything peculiar to Bud- "weis about this process or not, it seems that this beer "was really made as beer made in Budweis, of the best "barley and hops, and with the same preparation of "mash. The label states that it was made of the best "Saazar hops and imported barley. If this was not "literally true, the testimony is that it was a distinction "without a difference, imported hops exclusively were "used. There were frequently other hops, but they "were always of the same excellent quality as Saazar "hops and of the same peculiar properties, and were "always imported hops. The barley was not imported, "but a select quality of American barley, equal to "imported barley was always used. There was no testi- "mony tending to show any imposition upon the public "by the plaintiff. The testimony is that the public was "furnished by him with an excellent quality of beer "made of imported hops and of barley equal to any to

" be found in Europe or America." The Court accordingly granted the injunction.

In *Funke* v. *Dreyfus*, 34 La. Ann., 80, the plaintiff advertised its bitters as "imported." As a matter of fact these bitters were not imported, but as there was no evidence of intention to deceive the public, the Court granted the plaintiff relief.

In *Moxie Nerve Food* v. *Baumbach*, 32 Fed. R., 205, the trade-mark sought to be protected asserts:—

" That the Moxie Nerve Food contains not a drop of " medicine, poison, stimulant or alcohol, but is a small " sugar-cane like plant grown near the equator, and fur- " ther south; was lately accidently discovered by Lieut. " Moxie; and has proved itself to be the only harmless " and effective nerve food known, that can recover brain " and nerve exhaustion."

It will be observed that the statement is made that the compound does not contain a drop of alcohol. As a matter of fact, alcohol was used to cut the flavoring oils, but it passes off, to a great extent, in the evaporation necessary for its manufacture. But it was found that there was alcohol left in the preparation.

It was also claimed that Lieut. Moxie discovered the preparation. That fact was not shown, though it was denied, and even the existence of such a person as Moxie was denied. It appears, however, that there was such a person as Moxie.

The advertisement was that it is a small sugar-cane like plant grown near the equator, and further south. It would seem that vegetable matter was only a small part of the compound, for the Court says:—

" The extracts of the chemist of the contents of the " bottles show a palpable quantity of the extract of

" vegetable matter after all else has been spirited away " by the action of the heat."

Notwithstanding all these extravagant statements made on the bottles, some of which were flavored by absolute falsehood, the Court granted the injunction.

Rogers Mfg. Co. v. *Rogers & Spurr Mfg. Co.*, 11 Fed. R., 495.

This case is instructive, and the well considered and well expressed opinion of Lowell, C. J., is entitled to great consideration.

W. Rogers & Son had acquired a reputation for a certain kind of plated silver-ware, and for a time were interested with the complainant corporation in the business, but at the time the suit was brought had ceased all connection with it. The goods were still known, however, as "Rogers & Son's" goods. The Court says: "The " defendants insist that the plaintiffs have made false " and fraudulent statements to the public, to the " effect that they are still manufacturing under the " direction and management of William Rogers, and " William Rogers, Jr., both parties have fallen into " the mistake of supposing that it was important " to have a Rogers and his son to authorize them " to use the trade-mark, Rogers & Son. The law " is not so. Any one might use that trade-mark for the " first time that it was used, and if there was no Rogers " in the same business no Rogers could complain. (*Levy* " v. *Walker*, L. R. 10 Ch. D., 436; *Massam* v. *Thurley* " *Co.*, L. R., 14 Ch. D., 748. It was unnecessary for the " plaintiffs to send round pictures of William Rogers and " his son, as they have done. Such a method of adver-

" tising is more appropriate to the trade in patent medi-
" cines. But I do not quite see the injury to the public
" in this course of action. I think there is little doubt,
" upon the facts proved, that the reputation which the
" goods marked 'Rogers' Son, and Rogers & Bro., and
" Rogers Bros. have now acquired, depends upon the
" conduct of those who now use those names, and not
" upon any supposition in the minds of the purchasers
" that the persons who originated the business still con-
" duct it. Under these circumstances it does not seem to
" me that the plaintiffs have disentitled themselves to
" relief."

We respectfully submit that the defendants in the above case made a much stronger showing against the plaintiff there than was ever, in any case, made against the complainant here, even before its packages were changed.

The entire decision of the Court is well worthy of perusal.

Price Baking Powder Co. v. *Fyfe*, 45 Fed. R., 799.

It appears that the plaintiff and its grantors had been making a baking powder known as "Price's Cream Baking Powder." As a matter of fact there was no cream whatever used in the preparation. The Court speaking of the word "cream" as used by the complainant, says: "The
" complainant is certainly entitled to protection in the
" use of this word, in connection with the baking powder
" it manufactures, unless it is adopted and used as
" descriptive of the article, its ingredients or character-
" istics. The word 'cream' in combination with the
" other words, 'Dr. Price's' or 'Price's Baking Powder'

"designates an article which as thus named was "unknown in the trade until adopted in 1866. It is not "descriptive of an ingredient of the article, or of its "quality or kind. The baking powder is neither com- "posed in part of cream, nor does that word convey the "idea that it is the 'best' or 'choicest,' as asserted by "the defendant. It is true the word 'cream' is often "used to designate the best part of a particular thing, "but not the thing itself, as for instance, the cream of a "story; but only in that relation has the word any such "significance. The complainant had a right to appro- "priate a word which had not been previously used to "identify his particular manufacture, and distinguish it "from articles of the same general nature, manufactured "and sold by others. When launched upon the market "it must be given a name by which it could be recog- "nized. It was called 'Cream Baking Powder'—a "word appropriated by the manufacturer—so that his "article would thereafter be known, dealt in, and distin- "guished from others. 'The first appropriator of a name "or device . . . which, by being associated with "articles of trade, has acquired an understood reference "to the originator or manufacturer of the articles, is "injured whenever another adopts the same name or "device for similar articles, because such adoption is, in "effect, representing falsely that the productions of the "latter are those of the former.' *Lawrence Manuf'g* "*Co.* v. *Tennessee Manuf'g Co.*, 11 Sup. Ct. Rep., 400, "March 2, 1891."

Societe Anoyme, etc., v. *West Distilling Co.*, 43 Fed. R., 416, was where an injunction should have been refused,

if there is anything whatever in appellant's contention in this case. One would suppose from reading the decision that the Court was particularly ingenious in discovering reasons for sustaining the injunction, notwithstanding fraudulent representations made by the plaintiff.

It is impossible for any one to read the advertisements of the liqueur manufactured and sold by the complainant in that case without receiving the impression that it is actually manufactured by the Benedictine Monks of the Abbey of Fecamp from herbs grown on the fallows of Normandy. Yet the fraud of the defendant upon the complainant and the public was so manifest that the Court granted the injunction.

Selchow v. *Baker*, 93 N. Y., 53, overruling *Fetridge* v. *Wells*, cited by the defendants in all actions of this character, is a very instructive and applicable case.

In *Cleveland Stone Co.* v. *Wallace*, 52 Fed. Rep., 431, the question was as to whether a statement upon plaintiff's goods not strictly true was yet so incorrect as to disentitle the plaintiff to relief. It seems the plaintiffs manufactured scythestones at a place called Grindstone City, Michigan, and placed upon the different scythestones different labels.

The Court says:—

"It is claimed that the case of the plaintiff is brought " within the operation of this rule by its own and its " predecessors' circulars and catalogues, stating that the " various patterns and brands of scythestones in contro- " versy are made at, *e. g.*, the 'Willow Creek Quarry,' " 'Green Farm Quarry,' 'Pt. Au Barques Quarry,' etc., " and 'from selected Huron grit,' 'from the best blue " 'Huron grit,' etc., whereas, the stones of various " names were made from the same quarries. The con-

'text in which these statements are found makes it "plain that the quarries thus designated are located at "Grindstone City, Mich., and in some cases this is ex- "pressly stated. There is nothing to prevent plaintiff "from thus nominally subdividing its properties at that "place, or giving to these titular subdivisions such names "as fancy may suggest. There is in such nomenclature "no material false statement, nor is the public misled "into the purchase of one class of goods instead of an- "other. If the manufacturer chooses to associate one "brand or trade-mark of his goods with a name arbi- "trarily given to a part of his works or quarries, no "wrong is done to the public, so long as he furnishes the "identical article demanded by the preference of his "customers. The representation that the stones are "made from 'selected' or 'the best blue Huron' grit "are substantially satisfied if the quality of the materials "used is not inferior to that which the trade have "accepted as of that grade.

"The points of difference between the stones made "and sold by plaintiff under the names of 'Quinnebog,' "'Western Red Ends,' 'Star,' 'Diamond,' 'Clear Grit,' "'Lake Huron,' mainly consist in patterns, size and "finish. The 'Western Red Ends' are distinctly marked "in the manner suggested by the name. The 'Quinne- "'bog' is characterized by a peculiar finish. The fact "that all are made from the same quarries or rock for- "mation is not evidence of a material false statement."

The following cases are in point:

Metzler v. *Wood*, 8 Ch. Div., 606.
Alexander v. *Morse*, 14 R. T., 153; 51 Am. R., 369.
Chappal v. *Sheard*, 2 Kay & J., 117.
Chappal v. *Davidson*, 2 Kay & J., 123.
Clark Thread Co. v. *Armitage*, 74 Fed., 936.
Comstock v. *White*, 18 How. Pr., 421.
Bloch v. *Standard, etc., Co.*, 95 Fed., 978.
Hoxie v. *Chaney*, 143 Mass., 592.
Comstock v. *White*, 18 How. Pr., 421.
Curtis v. *Bryan*, 36 How. Pr., 333.
Dole v. *Smithsen*, 12 Abbott's Pr., 237.

Dickson's Crucible Co. v. *Guggenheim*, 2 Brewster, 321.
Electro-Silicon Co. v. *Hazard*, 29 Hun., 369.
Edelsten v. *Vick*, 68 Jr., 7.
Feder v. *Benkert*, 70 Fed., 613.
Holloway v. *Holloway*, 13 Bevan, 209.
Keasby v. *Brooklyn Chemical Works*, 142 N. Y., 467.
Lee v. *Haley L. R.*, 1 Ch. Div., 155.
Marshall v. *Ross*, 8 Eq., 651.
Pillsbury v. *Pillsbury*, 64 Fed., 841.
Sen Sen v. *Britton*, 1891 Ch., 692.
Shaver v. *Heller, etc. Co.*, 108 Fed., 821.

All the authorities are agreed that if complainant can make anything like a satisfactory explanation of a seemingly false statement on his labels, and in his advertisements, he will not be turned out of court.

Apply this principle to the case at bar and the court must listen to our complaint against our adversary.

In 1894 the complainant left off the words "California Liquid Fruit Remedy" from the label on the bottle and in May, 1896, entirely changed the carton as before stated. Since these changes were made, we respectfully submit that, the most censorious critic cannot find just cause of reproach.

At the time the defendant, Clinton E. Worden & Co., flooded the market of the Pacific Coast with an imitation of plaintiff's medicine, the carton and the statements thereon were not only unobjectionable but declared fully the truth. The attention of the Court is here called to "Exhibit A," opposite p. 634. An inspection shows at once that all the objections theretofore made have been entirely obviated. After the name, which is printed in large capitals comes the following in small capitals, but so

plainly printed that there is no room for mistake: "This " excellent remedy presents in the most acceptable form " the medicinally laxative principles of plants known to " act most beneficially, to cleanse the system effectually, " to permanently overcome habitual constipation and the " many ills dependent on it; to dispel colds and head- " aches and prevent fevers, to act gently yet promptly on " the kidneys, liver and bowels. The juice of figs in " the combination is to promote the pleasant taste." What more can be said? Here is a frank declaration that the medicinal virtues of the preparation do not come from the juice of figs, and that the only purpose of figs in the combination is to promote the pleasant taste. On the other side of the carton is a printed statement regarding the character and efficiency of the remedy. Among other things is the following: "Its " efficiency and delicacy of flavor are due to the medicinal " and agreeable qualities of plants and aromatic carmina- " tives, skillfully combined with pleasant liquids, among " which may be mentioned the juice of figs." Another side of the carton is taken up with similar statements in the German language, while the fourth side is occupied by the same declaration in French and Spanish.

If the Court will now read the decisions adverse to complainant, and especially the opinion of the Circuit Court of Appeals in the Sixth Circuit, reported in 73 Fed. R., it will see that if the record before those Courts had been like the one before this, their decisions would have been for the complainant. In the case last cited the Court expressly declares that but for these alleged false statements of complainant it would be entitled to relief.

We insist first, last and all the time that *the statements contained on the packages or cartons of complainant are strictly true.* If objection is made on the ground that the name "Syrup of Figs" is in itself a misnomer or fraudulent, four things should be borne in mind. First, that the name was perfectly legitimate when adopted. Second, that it is the custom in the drug business (see testimony of Mr. Henry Michaels (pp. 215-216), to use a fancy name or phrase without regard to whether the name truly indicates the character of the article. This may not be in accord with the highest ethical principles, but has become in the drug business a universal custom. Third, that complainant, beginning first in 1887 in medical journals and afterwards in general newspapers and by circulars distributed by the million, has notified the world that the medical properties of the compound come from senna (pp. 63, 601-619). It was agreed that other exhibits to the same effect need not be printed (see p. 5). But the originals were before the Circuit Court of Appeals. They were sent up as part of the original record. (See bottom of p. 592 and top of p. 593.) Some of them were most appropos to complainant's contention.

The attention of the Court is called to the active efforts of complainant, to eliminate all just objection to the name by advertising far and wide the facts about the composition of the medicine (see Record, pp. 55, 56, 57, 58, 59, 60, 61, 62, 63 and 64. We do not believe a person can be found who will testify that he bought the medicine supposing it to be different in its composition from what it really is.

The defendant put witnesses on the stand who

testified as to what they supposed the medicine to be, from the name, but not one was called who ever bought the medicine. It is safe to say that all persons who actually need a laxative and buy complainant's remedy know just what they are buying. If complainant cannot obtain relief from the Courts it is not because any man, woman or child has been actually deceived.

Fourth, the statements on the carton carry the "antidote with the bane," to use the language of the Court in *Centaur Co.* v. *Robinson*, 91 Fed. R., 881. That case was where an attempt was made by the defendant to turn the plaintiff out of Court on the ground of a false statement contained in the plaintiff's label. The language of the Court is as follows:

"The first reason suggested why the plaintiff in this "case is not entitled to a decree restraining the defend- "ant from pursuing his business in the form he was car- "rying it on at the time the bill was filed is that on the "wrappers of the plaintiff's medicine, which is put upon "the market and sold to the public, is found the claim "or statement that the compound so sold is purely vege- "table, and it is insisted that the compound contains "bicarbonate of soda and Rochelle salts, which are min- "eral compounds. I do not regard the isolated state- "ment quoted as constituting a fraud of such a character "as that it ought to defeat the complainant's right to "invoke the assistance of the court. And, if there was "any such misrepresentation in that regard, the wrapper "carries the 'antidote with the bane,' because, in describ- "ing the ingredients as they are compounded in the "medicine, it appears that the ingredients are truth- "fully stated; and if Rochelle salts or bicarbonate of "soda, or any other ingredient that enters into the "medicine as compounded, is a mineral, the misstatement "is corrected at once by the statement on the wrapper, "which correctly names all the ingredients of which the

" medicine is compounded. I do not think this objection " is tenable."

By turning to the case of *Centaur Co.* v. *Neathery* in the same volume, at page 893, it will be seen just what the label was that is referred to by the Court in the foregoing opinion. Under the word "CASTORIA," the following words appear in quite large letters: "A " vegetable preparation for assimilating the food and reg- " ulating the Stomachs and Bowels of Infants and Child- " ren. Promotes Digestion, Cheerfulness and Rest. " Contains neither opium, morphine, nor mineral. Not " Narcotic."

It will be observed that there are two statements made. First: that it is a vegetable preparation, and second, the positive assertion is made that it does not contain any mineral. Just below these in small script is: "Recipe of old Doctor Samuel Pitcher," and in what purports to be this recipe we find Rochelle salts and bicarbonate of soda. There is no positive statement that this is the recipe for the compound, yet the Court held that by reason of this recipe being printed on the package the antidote to the false statement conspicuously printed as above set out is given. The attention of the Court is called to page 891, where the learned Judge in *Centaur* v. *Robinson* clearly states the true principles to be applied in cases of this kind, where a name is used upon articles of small value, giving the dishonest retail dealer the opportunity to supply the goods of the defendant, in response to a demand for the goods of the plaintiff.

The above case of *Centaur* v. *Robinson* is correct in principle, because it has been many times decided, that

even if statements are made which are not strictly true, the Court will not for that reason alone turn the plaintiff out by the shoulders. The principle to be deduced from the authorities is as follows: Unless the untrue representations are shown affirmatively to be material representations, and directly calculated and intended to deceive the public as to the character of the preparation used, the plaintiff will not be turned out of Court. This is the substance of all the later decisions upon the subject.

We insist that this principle and the authorities above cited are conclusive of the case. It is the turning point, and if the Court is of the opinion that the Complainant ought not to be taken by the shoulders and thrust out of a court of justice, the judgment of the Court below was right.

FRAUDULENT USE BY CLINTON E. WORDEN & CO. OF THE NAME SYRUP OF FIGS.

It was urged in the Court below, and is here, that the injunction goes too far in restraining the defendant in that Court from using the words "Syrup of Figs" or "Fig Syrup," as applied to a liquid laxative medicine.

The injunction does not forbid the defendant in the Court below, to make and sell a syrup of figs, using the words in their descriptive sense. What is enjoined, is the use of the name "Syrup of Figs" AS APPLIED TO A LAXATIVE MEDICINE.

The authorities in support of the judgment of the Court below as to the form of the injunction are uniform. We do not believe a well considered case can be found that would justify the refusal of an injunction against the use

of these words when applied to a laxative medicine. Why is appellant so anxious to be permitted to use the name of Complainant's medicine upon its packages? The record clearly shows why. It is because it is the name of a well known and very popular article, and if appellant defeats the injunction placed upon it by the Court below, it can do what was being done when this suit was brought, that is, sell its goods to retail dealers, who can and will, in answer to the call from a customer for "Syrup of Figs," pass out and sell petitioner's compound. If petitioner is successful in its contention it will be at liberty, and from what it has already done it will certainly avail itself of the opportunity, of perpetrating a fraud not only upon the complainant and ruining its business, but upon the public.

As we said before, the authorities, to the effect that, if the complainant is entitled to relief at all, it is entitled to an injunction entirely forbidding the use of the name as applied to a laxative medicine, are uniform.

Not one of the following cases, where the use of a name was entirely forbidden, but had more justification for the use of the name contended for, than Clinton E. Worden & Co. has for using the name "Syrup of Figs," as applied to a medicine.

All the cases cited below are based upon the theory that the defendant was using a name for a fraudulent purpose, viz.: to sell his goods as the goods of plaintiff.

"GLENFIELD STARCH" case. The defendant was enjoined from using the name of the town Glenfield, where he manufactured his starch.

Wotherspoon v. *Currie*, L. R., 5 H. L. 508.

There could be no trade-mark in the name "Glenfield," because it was a geographical name. The injunction was granted on the ground that the *defendant was using the name "Glenfield," as applied to starch*, in order to sell his goods as the goods of plaintiff.

"STONE ALE" case. There the defendant was enjoined from using the name of the town Stone, where he manufactured his ale.

Thompson v. *Montgomery*, 4. Ch. Div. 35, 50.

"GUINEA COAL" case was where the defendant was enjoined from using the name of the street where he carried on the coal business, or using the name "Guinea Coal Co."

Lee v. *Haley*, 5 Ch. App. Cas. 155.

"ANATOLIA LICORICE" case was where the defendant was enjoined from using the name of the country "Anatolia," as applied to a licorice.

McAndrew v. *Bassett*, 10 Jr., N. S., 40, 4 De Gex J. & S. 380.

"ETHIOPIAN," as applied to black cotton stockings.

Hine v. *Lart*, 10 Jr. 106.

"LONDON CONVEYANCE CO." case was where the defendant was enjoined from using the words "Conveyance Company" or "London Conveyance Co." or "Original Conveyance Co."

Knott v. *Morgan*, 2 Keen, 213.

"CAMEL HAIR BELTING" case.

Reddaway v. *Panham*, 1896 App. Cas. 199.

"YORKSHIRE RELISH" case.

Powell v. *Birmingham Vinegar Brewery Co.*, L. R., Ch. Div. 1895, Vol. 3, 449.

"CLUB SODA" case.

Cochran v. *McNish*, 1896 Appeals, 225.

The foregoing are all English cases, decided upon the proposition laid down in

Levy v. *Walker*, 10 Ch. Div. 436,

as follows:

"YOU MUST NOT USE A NAME, WHETHER FICTITIOUS OR "REAL, OR A DESCRIPTION, WHETHER TRUE OR NOT, WHICH "IS INTENDED TO REPRESENT TO THE WORLD THAT YOUR "BUSINESS IS MY BUSINESS, AND THEREFORE DEPRIVE ME, "BY A FRAUDULENT MISSTATEMENT OF YOURS OF THE "PROFITS OF THE BUSINESS WHICH WOULD OTHERWISE COME "TO ME."

"GARRETT'S SNUFF" case was where the defendant was enjoined from the use of its own name—"T. H. Garrett & Co., or the name "T. H. Garrett" in connection with the manufacture of snuff.

"AKRON CEMENT" case, *Newman* v. *Alford*, 51 N. Y. 192, where the defendant was enjoined from using the word "Akron" as applied to cement, though it plainly appeared upon the package that it was manufactured at Syracuse and not at Akron.

"EXTRA DRY" case, where the defendant was enjoined from using the words "Extra Dry" as applied to champagne.

Von Mumm v. *Frash*, 56 Fed. R. 830.

"ST. LOUIS LAGER BEER" case, where the defendants were enjoined from using the words "St. Louis Lager Beer."

Anheuser Busch Association v. *Piza*, 24 Fed. Rep. 149.

"ST. LOUIS WHITE LEAD" case was where the defendants were enjoined from using the words "Southwestern St. Louis" as applied to white lead.

Southern White Lead Co. v. *Cary*, 25 Fed. R. 125, and *Southern White Lead Co.* v. *Coit*, 39 Fed. 492.

"NERVE FOOD" case, where the defendants were enjoined from using the words "Nerve Food."

Moxie Nerve Food Co. v. *Baumbach*, 32 Fed. 205.

"SINGER MACHINE" case, 163 U. S. 169.

"MINNEAPOLIS FLOUR" case, where the defendants were enjoined from using the word "Minneapolis" as applied to flour. See elaborate opinion of Circuit Court of Appeals.

Pillsbury-Washburn Flour Mills Co. v. *Eagle*, 86 Fed. 608.

"GERMAN SWEET CHOCOLATE" case.
68 Cal. 68.

"SLICED ANIMALS" case.
Selchow v. *Baker*, 93 N. Y. 53.

"BROMO-CAFFEINE" case.
Keasbey v. *Works*, 142 N. Y. 467.

"CONGRESS SPRINGS" as applied to a mineral water.

Congress Springs Co. v. *High Rock Congress Springs Co.*, 45 N. Y. 291.

"BETHESDA MINERAL WATER" case.

Dunbar v. *Glenn*, 42 Wis. 118.

"BLUE LICKS MINERAL WATER" case.

Northcutt v. *Turney*, 41 S. W. 21.

"CHICAGO WAISTS" case, where the defendant was enjoined from using the words "Chicago Waists."

Gage-Downs Co. v. *Featherbone Corset Co.*, 83 Fed. 213.

"RED CROSS PLASTERS" case.

Johnson v. *Baer*, 82 Fed. 662.

"BAKER'S CHOCOLTE" case.

Baher v. *Sanders*, 80 Fed. 889.

"CANADIAN CLUB WHISKEY" case.

Walker v. *Hockstæder*, 85 Fed. 776.

"PLYMOUTH GIN" case.

Collinsplatt v. *Finlayson*, 88 Fed. Rep. 693.

"DYSPEPSIA TABLETS" case.

Stuart v. *F. G. Stewart Co.*, 91 Fed. 243.

The "CARROM" case, as applied to a game.

Williams v. *Mitchell*, 106 Fed. 168.

"CELERY COMPOUND" case.

Wells v. *Seigel*, 106 Fed. 77.

The "QUEEN QUALITY" case, as applied to shoes.

Thomas G. Plarche Co. v. *May Co.*, 105 Fed. 375.

"HEALTH FOOD" case.

Fuller v. *Huff*, 104 Fed. Rep. 141.

"GOLD DUST" case, as applied to a washing powder.

Fairbanks v. *Suchel*, *etc.*, 102 Fed. 327.

"OXFORD BIBLE" case, 101 Fed. R. 442.

Taking up first the late cases in the Federal Reporter above cited for discussion, we desire to call attention to the sweeping character of the injunctions, that courts, in these times, are obliged to issue, in order to prevent the stealing of business.

"While a descriptive word or a geographical or per-
" sonal name cannot constitute a technical trade-mark,
" yet when as here, an article has come to be known by
" the descriptive word, one may not use that word to
" palm off his goods as the goods of another who has
" first adopted it, and by which appellation the goods
" have come to be known."

Opinion by C. C. A., Seventh Circuit.

Williams v. *Mitchell*, 106 Fed. Rep. 168.

The Court below allowed defendant to use the word "carrom," as applied to a game board offered for sale to the public, provided it was so used as to show that it was the carrom board manufactured by the defendant and not the plaintiff.

The Appellate Court held the name was descriptive and not subject to trade-mark, but as applied to a game board, offered for sale to the public, the complainant had the exclusive use of it.

Descriptive words "Celery Compound" may constitute a trade-mark and be entitled to protection as such in connection with a head of celery, when it is shown by long use they have acquired a secondary meaning, as identifying the particular production of complainant.

The Court said, "Under the trend of the later author-
" ities on this subject, the use of these words as a trade-
" mark designating this particular preparation may be
" sustained."

Wells v. *Seigel*, 106 Fed. Rep. 77.

In *Thomas G. Plant Company* v. *May Co.*, 105 Fed. Rep. 375, the Court below had held that the words "Queen Quality," as applied to shoes, were not entitled to protection. On appeal, the order was reversed, the Court holding:

" Where the general purpose of a trade-name adopted
" by a manufacturer is to identify the origin or owner-
" ship of the articles to which it is attached, his right to
" protection in the exclusive use of such name, is not
" affected by the fact that the words used also denote
" quality."

The Court cites with approval, *American Wash Board Co.* v. *Saginaw Mfg. Co.*, 103 Fed. 281, giving from the opinion in that case the following quotation: "The
" circumstances vary greatly, but the underlying prin-
" ciple which is effective in the solution of such cases is
" that a party may not adopt a mark or symbol which
" has been employed by another manufacturer and by
" long use and employment on the part of that other has
" come to be recognized by the public as denoting the
" origin of the manufacture, and thus impose on the

"public by inducing them to believe that the goods "which this new party thus offers are the goods of the "original party."

In *Fuller* v. *Huff*, 104 Fed. 141, the Circuit Court of Appeals, in a carefully prepared opinion, states the law applicable to the use by one of the trade-name of another with great clearness.

The Court below had refused to enjoin the use of the words "Health Food" as applied to a food product, *where there was no imitation of the packages* and when the evidence did not show fraud upon the part of the defendant.

The Appellate Court reversed the judgment and ordered the Court below to grant an injunction, in accordance with the prayer of the complainant.

The decision is so directly in point, that instead of quoting from it, we respectfully ask the Court to read it. The opinion is by Judge Shipman. The opinion of the Court below (99 Fed. 439) should also be read.

"A trade-name differs from a trade-mark in that it "appeals to the ear more than to the eye, and hence the "character of the label or package used by an imitator, "is of no great force in determining an infringement."

Fairbanks v. *Luckel, etc.*, 102 Fed. 327.

The foregoing is a decision of the Circuit Court of Appeals, reversing the Court below in holding that the trade-name "Gold Drop," as applied to a washing powder, did not infringe upon the name "Gold Dust."

The attention of the Court is called to the opinion and citation of authorities.

The trade-name "Syrup of Figs" appeals especially to

the ear. A party who has already used it recommends it by word of mouth to another.

The use of the word "Oxford" on bibles enjoined in 101 Fed. Rep. 442.

Stuart v. *F. G. Stewart Co.*, 91 Fed. 243, was where the Circuit Court of Appeals of the Seventh Circuit reversed the order of the court below refusing to grant an injunction. The Appellate Court said: "An "article may be advertised and become known by its "name, or by certain catch words easily retained in the "memory, an imitation of which may be sufficient to "deceive persons exercising ordinary care, though the "wrappers in other respects may be dissimilar." The court below had refused an injunction (See 85 Fed. Rep. 778) on the ground that the defendant was using its business name in good faith.

Garrett v. *Garrett*, 78 Fed. Rep. 472:

In that case an injunction was sought by the owner of a snuff that had become popular under the name of "Garrett's Snuff," as against a corporation of the name of "T. H. Garrett & Co." that put upon the market a snuff purporting to be manufactured by it. On motion for preliminary injunction the court below restrained the defendant from in any way imitating the plaintiff's labels, but refused to enjoin it from using its name "Garrett & Co." as the manufacturers. The plaintiff appealed. The decision of the Circuit Court of Appeals (Sixth Circuit) is so apropos to this discussion that we respectfully request the Court to read it. The Court of Appeals reversed the judgment and ordered an injunc-

tion "against the use of the name of the defendant 'T. H. Garrett & Co.'" or the name of "Garrett" as a part of the corporate name of the defendant, or in its business.

In its opinion the Court cites with approval *Rogers Co.* v. *Wm. Rogers Manuf'g Co.*, 70 Fed. 101–7.

In that case, too, the defendant was enjoined from using its name.

How much more is the complainant in the case at bar entitled to relief, where the defendant does not use its own name in labeling its goods, but assumes fictitious names resembling complainant's, for the manifest purpose of deceiving unwary customers. Further than that, it assumes the use of the name of complainant and makes it part of the fictitious name. This name of complainant too has become identified with its medicine. Observe the remarks of Judge Morrow upon this matter in 86 Fed. R. at p. 218, where he says, after speaking of *Redaway* v. *Banham*, to which we shall refer further on: "It will be observed that complainant's right is more "closely identified with the name of the article. The "name Fig Syrup or Syrup of Figs was not known to "the world as a liquid laxative until it was prepared by "the complainant and it was not then known as such an "article in any way distinguished from its production by "the complainant. *This is an important fact to be "taken into consideration in determining whether the "defendants are engaged in unfair competition.*"

Why did the defendants select this name as applied to a medicine? Is there any other answer possible than that it was done to sell their compound as and for plain-

tiff's medicine? Is it not a palpable theft of a trade? Will the Court protect the appellant in this fraud?

Lawrence Manufacturing Co. v. *Tennessee Manufacturing Co.*, 138 U. S. 537, was where a bill was filed to enjoin the use of the letters "L. L." upon sheetings, the plaintiff claiming a trade-mark right thereto. The Court, per Fuller, Chief Justice, decided that the plaintiff had no right to the letters "L. L." as a trade-mark. The court below had found *that the letters "L. L." were in common use by manufacturers of sheetings to designate 4-yard goods*, and such being the case, the plaintiff, though it had first used the letters "L. L.," was not entitled to a trade-mark, nor to the exclusive use of them. The Court said: "the significance of the letters "'L. L.' stamped upon cotton sheetings as indicative of "grade, class and quality, was generally understood in "the trade when defendant commenced the use of said "letters." It appeared that many other manufacturers used the same letters to distinguish the same class of goods.

At page 551 the Court says:—

"If in this case the letters 'L. L.' *formed an important "part of plaintiff's label* and the defendant had used "them in such a way and under such circumstances as "to amount to a false representation, which enabled it "to sell, and it did sell its goods as those of the plain-"tiff, and this without plaintiff's consent or acquiescence, "then plaintiff might obtain relief within the principle "of the cases just cited."

The italics are ours.

Now what are the cases "just cited" with approval?

They are—

The Glenfield Starch Case, and

The Stone Ale Case.

These two cases cited with approval, as above stated, dispose of the contention here. We copy herewith from pages 550 and 551, in the above report, what this Court says about those two cases:—

"In *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508, "the plaintiffs had manufactured starch at Glenfield, "which had become known as 'Glenfield Starch.' They "removed from Glenfield, but continued to call their "starch by the same name. The defendant, though his "place of business was at Baisley, *commenced manufact-* "*uring starch at Glenfield*, and selling the same in Scot- "land with the words 'Glenfield Starch' printed on the "labels. This was interdicted by the Court of Session, "but he continued to sell in England under a label of "which 'Glenfield' in larger or darker letters than "any other on the packets was the pronounced feature, "and the house of lords held that he was putting the "word 'Glenfield' on his labels fraudulently, and with "the intention of making out that his starch was the "starch of plaintiff, who had by user acquired the right "to the name of 'Glenfield Starch,' and enjoined him "from so doing. In *Thomson* v. *Montgomery*, 41 Ch. "Div. 35, 50, the plaintiffs and their predecessors had "for a hundred years carried on a brewery at Stone, and "their ale had become known as 'Stone Ale.' They "had registered several trade marks, which contained "the words 'Stone Ale' in combination with some "device or name of their firm, and in 1888 they "registered as an additional trade mark the words "'Stone Ale' alone. The defendant *built a brewery at* "*Stone*, over which he placed the words 'Montgomery's "'Stone Brewery,' with a device containing the words "'Stone Ale,' and a monogram somewhat resembling "the plaintiff's trade mark. It was held that the "plaintiffs could not register 'Stone Ale' as a trade "mark under the act of parliament in that behalf, but

" that they had acquired by user the right to the use of " the words 'Stone Ale'; and that, the conduct of the " defendant being, in the opinion of the Court, calcu- " lated to deceive the public into supposing that his ales " were brewed by plaintiffs, they were entitled to an " injunction. Lord Justice Lindley remarked that, " although the plaintiffs had no exclusive right to the " use of the words 'Stone Ale' alone as against the " world, or any right to prevent the defendant selling his " goods as having been made at Stone, yet, 'as against " a particular defendant who is fraudulently using, or " going to fraudulently use,' the words with the express " purpose of passing off his goods as the goods of the " plaintiffs, it appears to me that the plaintiffs may have " rights which they may not have against other traders. " In regard to that proposition, it appears to me that the " Glenfield starch case has an extremely important bear- " ing upon this case. The evidence in this case con- " vinces me that any ale which may be sold by this " particular defendant as 'Stone Ale' will be intended " by him to be passed off as the plaintiff's ale. I am " satisfied that he does not use the words 'Stone Ale' " for any honest purpose whatever, but, according to the " evidence, with a distinctly fraudulent purpose. Is " there any reason, then, why the Court should not deal " with him accordingly, and prevent him from carrying " out such intention, by restraining him from using the " words which he will only use for that purpose? In my " opinion the Glenfield starch case warrants us in going " that length as against this particular defendant."

It was after giving these quotations that the Court held that if plaintiff were using the mark "L. L." so as to form an important part of its label, and the defendant were using these letters so as to enable it to deceive customers, the defendant should be enjoined from using those letters.

We submit that this decision completely disposes of petitioner's contention.

In both the above cases the courts gave to plaintiffs the exclusive right to geographical names upon their goods. As is well known, geographical names cannot be appropriated as a trade-mark. How much stronger they are than this case where the defendant takes the name by which a medicine has become known in the market, and also adopts part of the corporate name of complainant for the sole purpose of enabling retail druggists to palm off its compound upon unwary or ignorant customers.

In *Singer Manufacturing Co.* v. *June Manufacturing Company*, 163 U. S. 169, and *Singer Manufacturing Company* v. *Bent*, 163 U. S. 204, this Court held that the word "Singer" as applied to a sewing machine, having been protected by U. S. Patent, one of the considerations for said protection was that at the expiration of the patent the name should become common property. It therefore held that anybody had a right to make a machine, in accordance with Singer Patent, and call it a Singer machine, but in both cases the Court made the following order:—

"It follows that the decree below must be reversed "and the cause be remanded with directions to enter a "decree in favor of complainant with costs, perpetually "enjoining the defendant, his agents, servants and "representatives, from marking upon sewing machines "made or sold by him, or upon any plate or device con-"nected therewith, or attached thereto, the word "'Singer,' or words or letters equivalent thereto, with-"out clearly and unmistakably specifying in connection "therewith that such machines are the product of the "defendant or other manufacturer, and not the manu-"facture of the Singer Manufacturing Co."

That is to say, the Court decided that the defendant had the right to use the word "Singer" as applied to sewing machines for the reasons hereinbefore stated, but in using the word "Singer" upon a machine, the defendant must also state as a part of the label or name that this particular machine was not manufactured by the original Singer Manufacturing Company, but by himself.

"Equity gives relief in such case, upon the ground "that one man is not allowed to offer his goods for sale, "representing them to be the manufacture of another "trader in the same commodity. Suppose the latter has "obtained celebrity in his manufacture, he is entitled to "all the advantages of that celebrity, whether resulting "from the greater demand for his goods or from the "higher price the public are willing to give for the "article, rather than for the goods of the other manu-"facturer, whose reputation is not so high as a manu-"facturer. Where, therefore, a party has been in the "habit of stamping his goods with a particular mark or "brand so that the purchasers of his goods having that "mark or brand know them to be of his manufacture, no "other manufacturer has a right to adopt the same "stamp; because, by doing so, he would be substantially "representing the goods to be the manufacture of the "person who first adopted the stamp, and so would or "might be depriving him of the profit he might make "by the sale of the goods which the purchaser intended "to buy. *Seixo* v. *Provezende*, Law Rep. 1 Ch. 195."

McLean v. *Fleming*, 96 U. S. at page 251.

"Chancery protects trade marks upon the ground that "a party shall not be permitted to sell his own goods as "the goods of another; and, therefore, he will not be "allowed to use the names, marks, letters, or other "indiciæ of another, by which he may pass of his goods "to purchasers as manufacture of another. *Newman* "v. *Alford*, 51 N. Y. 192."

Idem, page 255.

Newman v. *Alford*, cited above by this Court, is sometimes called the *Akron Cement case*. The Court there held that the plaintiff had the right to the geographical name "Akron" as a trade mark as against the defendant. The plaintiff placed upon the barrels of lime the following words: "Newman's Akron Cement Co., Manufactured at Akron, N. Y." The defendant labeled their barrels as follows: "Alford's Anondaga Akron Cement or Water Line, Manufactured at Syracuse, N. Y." The Court says, page 192:—

"They placed the word 'Akron' upon their label for "the purpose of increasing their sales and availing them- "selves of the reputation acquired by plaintiff's cement."

At page 195 the Court, speaking of trade marks, says:—

"The right must be exclusive as against the defend- "ant. It is generally sufficient, in such cases, if plaintiff "has the right and the defendant has not the right to "use it. The principle upon which the relief is granted "is that the defendant shall not be permitted, by the "adoption of a trade mark which is untrue and de- "ceptive, to sell his own goods as the goods of the "plaintiff, thus injuring the plaintiff and defrauding the "public."

The Court cites with approval *Lee* v. *Haley*, 5 Ch. App. Cas. 155, and goes on to say:

"In *Lee* v. *Haley* the plaintiff had for a series of years "carried on business as coal dealers in Pall Mall, Lon- "don, under the name of 'The Guinea Coal Company,' "and they were frequently called 'The Pall Mall Guinea "Coal Company.' The defendant, who had been their "manager, finally set up a business in the same street "under the same style of 'The Pall Mall Guinea Coal "'Company,' and while it appeared that there were other "Guinea coal companies in London, so that the plaintiffs "did not have the exclusive right to the use of the trade- "mark, 'Guinea Coal Company,' yet the Court held that

" they were entitled, as against the defendant, to be pro-
" tected in the use of the name. Lord Justice Gifford,
" writing the opinion of the court, says: 'I quite agree
" ' that the plaintiffs have no property in the name; but
" ' the principle, upon which the cases on this subject
" ' proceed, is, not that there is property in the word, but
" ' that it is a fraud on a person who has established a
" ' trade and carries it on under a given name, that some
" ' other person should assume that same name or the
" ' same name with a slight alteration, in such a way as
" ' to induce persons to deal with him in the belief that
" ' they are dealing with the person who has given a
" ' reputation to the name.' This case goes further than
" it is necessary to carry the rule in the case before us,
" because the words 'Pall Mall Guinea Coal Company'
" could be truthfully used by both parties. They both
" sold coal in Pall Mall for a guinea a ton. But here
" the defendants could not truthfully call their cement
" Akron cement, and they had no shadow of right to use
" the name. Their use of it was a fraud upon the plain-
" tiffs, and upon no other manufacturers.

" These views are not in conflict with the case of *The*
" *President, Managers and Company of the Delaware*
" *and Hudson Canal Company* v. *Clark*, recently de-
" cided in the Supreme Court of the United States, not
" yet reported."

. . . " That the name of a place can thus be appro-
" priated, has, during the present year, been decided on
" appeal in the House of Lords, in the case of *Wotherspoon*
" v. *Currie*, reported in 5 House of Lords, English and Irish
" Appeals (Law Reports), 508. In that case the plain-
" tiffs, and those to whom they succeeded, had formerly
" carried on the business of starch-makers at Glenfield,
" near Paisley, and their starch had become known in
" market and was sold as Glenfield starch. After the
" plaintiffs' starch had become thus known, they removed
" their starch-works from Glenfield to another small place
" near Paisley, and there continued to manufacture their
" starch, which continued to be known and sold as Glen-
" field starch. *The defendant afterward commenced to*
" *manufacture starch at Glenfield, and placed on the*

" *labels upon his packages of starch the word Glenfield,* " *and sold his starch as Glenfield starch. He claimed the* " *right to do this because his starch was made at Glenfield* " *and the plaintiffs' was not. But it appeared that he* " *used the word Glenfield for a fraudulent purpose; to* " *increase his sales at the expense of the plaintiffs, by* " *inducing the public to purchase his starch under the* " *belief that it was the starch made by the plaintiffs,* " *and it was held that the plaintiffs were entitled to be* " *protected in the use of the word as their trade-mark. The* " *defendant could truthfully apply the word Glenfield to* " *his starch, but he was restrained because he applied it with* " *a fraudulent and dishonest purpose.* In the case at bar " the defendants not only used the word Akron, as applied " to their cement, for a fraudulent and dishonest purpose, " but there is the additional element that they could not " truthfully use it, and, hence, for more reason than in " the case last cited, they ought to be restrained."

The italics are ours.

Von Mumm v. *Frash*, 56 Fed. Rep. 830.

In 1886 plaintiffs, at Reims, France, originated a champagne having a dry flavor, which has since been very extensively sold in the United States as "G. H. Mumm & Co.'s Extra Dry," and is distinctively known by the term "Extra Dry." The defendants sell an American wine in ordinary champagne bottles. "On the " upper part of the principal label they put the words " Extra Dry,' and also a colorable imitation of the impe- " rial mantle bearing a colorable imitation of the Mumm " trade-mark." The opinion of the Court was by Benedict, Judge. He says: "The words Extra Dry thus applied " to the wine in question when it was first put upon the " market have been so extensively used to designate this " particular wine that the words have come to be to a " large extent a name whereby to distinguish the wine as

"wine manufactured by the complainants and of the "quality of the wine originated by them in 1866."

After discussing the differences between the labels on the plaintiff's wine and the defendant's wine, the Court says:

"This difference in the principal labels is of little "importance, however, by reason of the fact proved, that "the principal label of a bottle of champagne is fre- "quently gone when served, or, if present when served, "frequently covered. For the same reason it is of little "importance to the present controversy that the defend- "ants put their own name upon the principal label of "their bottles and do not put there the name of G. H. "Mumm & Co. What is of importance is that the "defendants on the principal label of their bottles put "the words 'Extra Dry' coupled with an imitation of the "trade-mark of G. H. Mumm & Co. . . . . "In connection with the use of the words 'Extra Dry,' "by the defendants it is important to observe that the "testimony discloses that the words 'Extra Dry' are not "used by the defendants to describe any quality of their "article but for the purpose of fraud."

The Court finds: "That they do not use the words "'Extra Dry' for the purpose of describing any quality "of their article, but to enable their article to be put off "as the wine of complainants."

The Court quotes with approval the following language from *Koehler* v. *Sanders*, 127 N. Y. 74:

"There are cases where the right to use a name to "designate a product is so qualifiedly exclusive that the "right to the protection of its use against infringement "by others rests upon the ground that such use by them "is an untrue or deceptive representation. The appli- "cation of this principle is not necessarily dependent "upon a proprietary right in a name, or the exclusive "right to its use. But when another resorts to the use "of it fraudulently, as an artifice or contrivance to repre- "sent his goods or his business as that of the person

" so previously using it, and to induce the public to so " believe, the Court may, as against him, afford relief to " the party injured."

The Court then refers to *Thompson* v. *Montgomery*, and other cases, as follows:—

" In *Thompson* v. *Montgomery*, 41 Ch. Div. 35, cited " by the Supreme Court in the case of *Coats* v. *Thread* " *Co.*, hereafter referred to 149 U. S. 562, 13 Sup. Ct. " Rep. 966), the controversy related to ale manufactured " at Stone, in Staffordshire. There, in deciding to enjoin " the defendants from using the words 'Stone Ale,' " the Judge says (page 51):—

" I am satisfied that the defendant does not use the " words 'Stone Ale' for any honest purpose whatever, " but, according to the evidence, with a distinctly fraud- " ulent purpose. Is there any reason, then, why the " Court should not deal with him accordingly, and pre- " vent him from carrying out such intention, by restrain- " ing him from using the words which he will only use " for that purpose?"

In the case of *Johnston* v. *Ewing*, L. R 7 App. Cas. 219, the House of Lords say:—

" No man has a right to adopt and use so much of " his rival's established trade mark as will enable any " dishonest trader, into whose hands his own goods may " come, to sell them as the goods of his rival."

In *Manufacturing Co.* v. *Loog*, 18 Ch. Div. 412, it is said:

" No man is permitted to use any mark, stamps, or any " other means whereby, without making a direct false " representation himself to a person who purchases " from him, he enables such person to tell a lie, or " make a false representation, to somebody else, who is " the ultimate customer."

Says the Lord Chancellor in *Wotherspoon* v. *Currie*, L. R. 5 H. L. 517:

"It was long ago pointed out that it is not upon the "*mala mens* towards the buyer that the decision of the "case rests."

In *Lever* v. *Goodwin*, 36 Ch. Div. 1, the Court says:—

"Now, it has been said more than once in this case, "the manufacturer ought not to be held liable for the "fraud of the ultimate seller; that is, the shopkeeper "or the shopkeeper's assistant. But that is not the "true view of the case. The question is whether the "defendants have or have not knowingly put into the "hands of the retail dealers the means of deceiving the "ultimate purchasers.

"The question thus stated I consider to be the ques- "tion here, and the answer must be that the defendant "knowingly put into the hands of the retail dealers an "article of the defendants' manufacture, so dressed up "that, in the hands of the retail dealers, it is an effec- "tive means of deceiving the ultimate purchaser into "the belief that he is purchasing the champagne wine "of the complainant known as G. H. Mumm & Co.'s "Extra Dry."

The Court decided, page 839, what the form of the injunction should be, saying:—

"They should be also prohibited from placing words "'Extra Dry' upon any bottles of their product, of the "character that has been described, either in combina- "tion or otherwise. This upon the ground that the "words 'Extra Dry,' as applied by them to the article "they manufacture, constitute an untrue and deceptive "representation, made, not for the purpose of descrip- "tion, but for the purpose of fraud, and which are "calculated to deceive, to the injury of the complain- "ants."

Anheuser Bush Brewing Association v. *Piza*, 24 Fed. 149, is where Judge Wallace, of the New York Circuit, enjoined the defendant from using the words "St. Louis

Lager Beer," because the defendant could only use those words for the purpose of getting the trade of the complainants.

In *Southern White Lead Co.* v. *Cary*, 25 Fed. 125, the plaintiff used the following words upon its kegs of lead: "Southern Company, St. Louis." The defendants who were manufacturing white lead at Chicago, put on their kegs: "Southwestern. St. Louis." The Court, Gresham, Justice, closed its opinion by this order:—

"A temporary injunction will be granted restraining "the defendants from branding upon their kegs the "words 'Southwestern. St. Louis.'"

The Judge in his opinion says:—

"I shall not stop to inquire whether the complain- "ant's claim to trade mark is or is not well founded, as I "think it is entitled to an injunction upon another "ground. The defendants so brand the heads of their "kegs as to naturally mislead and induce persons pur- "chasing for consumption to suppose they are pur- "chasing the complainant's lead, when they are getting "an inferior article. . . . The defendants sell their "goods to retail dealers, and it may be that such dealers "are not deceived, but they sell to customers who are "or may be deceived. The complainant is entitled to "relief if the brand used by the defendants sufficiently "resembles the complainant's brand to be mistaken for "it, and the defendants adopt their brand for the pur- "pose of selling their kegs as the kegs of the complain- "ant, or for the purpose of enabling retail dealers to do "so, and the complainant has been injured by this fraud, "or is likely to be injured by it."

In *Southern White Lead Co.* v. *Coit*, 39 Fed. 492, Judge Blodgett at Chicago granted a similar injunction.

Moxie Nerve Food Co. v. *Baunbach*, 32 Fed. 205, is directly in point, as well upon the propriety of enjoining

the defendant from using a name to which the plaintiff has no trade-mark right as upon the proposition already advanced, that the plaintiff is not guilty of such fraud as will prevent the Court giving relief. This case is cited with approval by Judge Colt, in *Moxie Nerve Food Co.* v. *Beach*, 33 Fed. Rep. 248, and by Judge McKenna in *California Fig Syrup Co.* v. *Improved Fig Syrup Co.*, 51 Fed. Rep. 296. The opinion is by Judge Sabin. He approved the preliminary injunction granted in that case in the following words:—

"The defendants, and each of them, . . . are hereby "restrained and enjoined . . . from using the words "'Nerve Food,' either alone or with other words, upon "the outside or upon the wrapper of any package con- "taining the manufacture of a fluid resembling in taste, "flavor, or appearance the article manufactured by com- "plainants as 'Moxie Nerve Food.'"

Knott v. *Morgan*, 2 Keen, 213; *Cox Trade Mark Cases*, 637; was where the plaintiff, running omnibuses in London, painted on their omnibuses the words "Conveyance Company" and "London Conveyance Company." The defendant then placed on its omnibuses the same words, and sometimes "Original Conveyance Company."

The Court ordered an injunction forbidding the use of these words, and saying: "It is not to be said that the "plaintiffs have any exclusive right to the words 'Con- "'veyance Company,' or 'London Conveyance Company,' "or any other words; but they have a right to call upon "this Court to restrain the defendant from fraudulently "using precisely the same words and devices which they "have taken for the purpose of distinguishing their "property, and thereby depriving them of the fair profits

"of their business by attracting custom on the false "representation that carriages, really the defendants, "belong to and are under the management of the plain- "tiffs."

The *Collins Co.* v. *Brown case*, 3 Kay & Johnson, 423, was where there was no technical trade-mark, but the Court held:

"A person who has been in the habit of using a "particular mark, may prevent other persons from "fraudulently taking advantage of the reputation which "his goods have acquired, by using his mark in order to "pass off their goods as his, to his injury."

In rendering the opinion Sir Page Wood the Vice-Chancellor said:

"If a man has been in the habit of using a particular "mark for his goods for a long time, during which no "one else has used a similar mark, and then another "person begins to use the same mark, that can only be "with a fraudulent intent."

In Judge Morrow's opinion in *California Fig Syrup Co.* v. *Worden*, 86 Fed. Rep. 212, he refers to what is now the leading and most famous case upon the law of unfair competition in trade. It is a case that is now being continually referred to in the courts of England and this country as the fullest and most decisive discussion of the principles involved in cases like the one at bar. It is

Reddaway v. *Benham*, 1896, App. Cas. 199.

It was decided by the House of Lords and evidently all the Law Lords took part in the decision, each giving his opinion.

It seems that in 1877 Frank Reddaway had begun the manufacture of belting for machinery from hair and wool purchased in the market, and gave to his manufactured

product the name of "Woolen Belting." In 1879 he began to call the belting "Camel Hair Belting." The belting was stamped "Camel" or "Camel Hair." It seems that it was not known by the plaintiff or by Frank Reddaway, its grantor, that the hair which he bought in the market and out of which he made his belting was in fact composed principally of the hair of camels, and this fact did not come out until some time during the trial of the case, when, to the surprise of all parties, it was learned that the hair of commerce used by both the defendants and the plaintiff alike was actually camel's hair. Plaintiff's belting became very popular in foreign countries, especially in hot climates, and a large trade was built up. The article came to be known as "Camel Hair Belting." The defendant purchased the same kind of raw material, and commenced the manufacture of belting and called it "Camel Hair Belting," which was the exact truth.

Three material questions were submitted to the jury. The questions and their answers were as follows:—

1. Q. Does "camel hair belting" mean belting made by the plaintiff as distinguished from belting made by other manufacturers?

A. Yes.

2. Q. Does it mean belting of a particular kind without reference to any particular maker?

A. No.

3. Q. Do the defendants so describe their belting as to be likely to mislead purchasers and to lead them to buy the defendant's belting as and for the belting of the plaintiff?

A. Yes.

There was no question made in the case after it was ascertained that the material out of which the belting made by both the plaintiff and the defendant was in truth and in fact camel's hair, but what the name used by the defendant was materially and exactly true. Nevertheless the trial court "granted an injunction " restraining the defendants from continuing to use the " words 'camel hair' in such a manner as to deceive pur- " chasers into the belief that they are purchasing belt- " ing of the plaintiff's manufacture and from thereby " passing off their belting as and for the belting of the " plaintiff's manufacture."

This judgment was reversed by the Court of Appeals, from which judgment of reversal the plaintiff appealed to the House of Lords. Four days seem to have been given to the argument. Upon the argument the distinguished counsel for the plaintiff evidently relied principally upon the *Glenfield Starch Case* and the *Stone Ale Case*. The counsel for defendants contended that: " plaintiffs have tried to place a secondary meaning on a " plain English expression composed of ordinary words " and seek to prevent the whole world from using that " expression without some distinguishing words. There " is no authority for such a contention. Authority is " the other way. There is an inherent right to describe " one's goods in plain terms which are a true description " and not the less so because other people have used the " same description, and the plaintiffs cannot claim the " exclusive use of a truthful description such as 'camel " 'hair belting.' The defendants do no wrongful act, but

" are only exercising their natural rights in using a true " description and are not to be restricted because some " of the public may make mistakes. . . . There was " no imitation of the plaintiff's labels or marks. The " evidence did not support the findings. There was no " evidence of fraud and fraud is essential to the plaintiff's " case."

The House of Lords took some time for consideration, and at a subsequent date the Lord Chancellor, Lord Halsbury and the following ex-Lord Chancellors rendered opinions, viz: Lord Herschel, Lord Morris, and Lord Macnaghten. The discussion is so elaborate and so pertinent to the questions involved here that the attention of this Court is respectfully called to the four opinions rendered in the case. But this should at all times be borne in mind, that the name used by both the plaintiff and the defendant, for their product truthfully described the article, viz: that it was a belting made of camel hair. Therefore the Court had no power to prevent the defendant from using that name in the description of his goods, but it ordered a judgment as follows, viz:—

"An injunction restraining the defendants, and each of " them, from using the words 'camel hair' as descriptive " of or in connection with belting manufactured by them, " or either of them, or belting not being of the plaintiff's " manufacture sold or offered for sale by them, or either " of them, without clearly distinguishing such belting " from the belting of the plaintiffs."

The court in the decree follows the form given by this Court in *The Singer case* (163 U. S.).

In both cases this form was made necessary because of defendant's absolute right to use the name.

Another recent case in England often cited is the case of

Powell v. *Birmingham Vinegar Brewery Co.*, L. R. Ch. Div., 1894, Vol. 3, 449.

The plaintiff in that case had manufactured a sauce and given it the name of "Yorkshire Relish." He built up a large trade in the article and registered the words "Yorkshire Relish" as a trade mark. The defendant instituted an action under the British Statutes to have the registration of the trade mark "Yorkshire Relish" canceled on the ground that the words were not susceptible of being appropriated as a trade mark. After much litigation between the parties the trade mark was canceled for the reasons stated. Thereupon the defendant put upon the market a sauce to which it gave the name "Yorkshire Relish." The plaintiffs brought an action in equity to restrain the defendants. The decision of the lower court was that the defendants be restrained from using the words "Yorkshire Relish" as applicable to sauces other than those of the plaintiff's manufacture without clearly distinguishing the same from the sauce of the plaintiff. The defendants appealed from this order, contending that its terms were such that it prevented them using the words "Yorkshire Sauce" at all, and gave to the plaintiff a monopoly in those words to fully as great an extent as if they constituted of a valid trade mark. In the discussion by the Judges of the Court of Appeals it was assumed that the effect of the injunction was as stated by the counsel for the defendant.

The Court of Appeals affirmed the judgment of the Court below.

In the above case (the Yorkshire Relish case) there was no question of imitation of packages, except by the use of the words "Yorkshire Relish." The plaintiff's sauce was stamped "The Celebrated Yorkshire Relish, Goodall, Backhouse & Co.," followed by the name of the manufacturer. The defendant's article was stamped "Holbrook's Yorkshire Relish," followed by the words "Manufactured by the Birmingham Vinegar Brewery Co., Limited, Successors to Holbrook & Co., London & Birmingham." The opinions of the different judges are very elaborate and the whole case merits the examination of this Court. At page 68 the Court says: "In cases "of this description the probability of misleading not "experts or persons who know the real facts, but the "ordinary or unwary customers, is the mischief to be "guarded against."

The case of *Reddaway* v. *Banham*, then recently decided by the House of Lords, is discussed at considerable length. At the bottom of page 75 the Court says: "The "evidence plainly shows the value to the plaintiff of the "name of Yorkshire Relish. The name not only denotes "a particular kind of sauce, but it denotes the same sauce "which the plaintiff and he alone has hitherto made. "Those persons who are in the trade, or who read all "that is on the labels, know that the Yorkshire Relish "is the sauce made by the plaintiff for which he is "famous. At the same time it is true that great num-"bers of ordinary retail buyers are guided by the words "'Yorkshire Relish'; such persons do not attend to any-"thing else on the labels. So long as 'Yorkshire Relish' "are the conspicuous words, an alteration in the label does

" not attract the attention of the great majority of buyers,
" or give rise to any suspicion that the sauce with the
" altered label is not the same, or does not come from the
" same makers as that which they are accustomed to
" buy, or have been told to ask for. The evidence on
" this point is very strong, so strong that I doubt the
" possibility of any one selling sauce in ordinary round
" sauce glass bottles with Yorkshire Sauce conspicuous
" upon them without misleading the public and seriously
" injuring the plaintiff. What might happen if a rival
" maker of 'Yorkshire Relish' sold it in bottles unlike ordi-
" nary glass sauce bottles, or in some other vessel wholly
" unlike the bottles used by the plaintiff, or at prices so
" dissimilar as to attract attention, there is no evidence to
" show. Perhaps it would not be worth anybody's while
" to attempt to court a trade in Yorkshire Relish under
" such conditions. . . . The defendants have taken
" care not to imitate the plaintiff's label nor his trade-
" mark of a plate. Moreover the defendants print their
" own names in conspicuous letters on their own label.
" They have a round gilt disc instead of a round plate
" and they now sell their own sauce in pink and not white
" wrappers. In short, when both the plaintiff's and the
" defendant's sauces are looked at as they are sold the
" differences between the two are apparent enough to
" anyone whose attention is drawn to them. . . .
" But above all the words 'Yorkshire Relish' are as con-
" spicuous on the defendant's bottles as on the plaintiff's.
" The consequence is that, notwithstanding the differ-
" ences to which I have alluded, the evidence proves that
" the defendant's sauce can be and in fact is easily mis-

" taken by ordinary buyers for the sauce which the plain-
" tiff has long made and sold, and still makes and sells
" under the name of Yorkshire Relish."

Kay, Lord Justice, in giving his opinion says (p. 82) that the ordinary purchaser when he asks for an article like this by the name of Yorkshire Relish probably never notices the name of the maker at all. "The defendants " urge that the plaintiff has no right to the exclusive use " of the words 'Yorkshire Relish' and that to prevent " the defendants from using them as they are doing would " in effect be to give the plaintiff the exclusive use of " those words." The Judge then quotes from the *Stone Ale case* as follows:

"The respondents are entitled to ask that a rival manu-
" facturer shall be prevented from selling his ale under
" such a designation as to deceive the public into the
" belief that they are obtaining the ale of the respondents,
" and he ought not the less to be restrained from the
" doing so, because the practical effect of such restraint
" may be much the same as if the persons seeking the
" injunction had a right of property in a particular name."

Lord Justice Smith said at page 86, referring to the argument of the counsel:—

" Mr. Moulton when asked what it was that prompted
" his clients to take for their sauce the name 'York-
" 'shire Relish' and to give the name such prominence
" upon their wrappers and labels, and why they were not
" content to call their sauce either as 'Holbrook's Sauce'
" or 'Holbrook's Relish' or by the name of any other
" relish they might choose other than 'Yorkshire Relish'
" (and there are many other relishes known in commerce),
" at once boldly stated that the defendants' object was
" (and indeed it was obvious without his statement), to
" compete with the plaintiff in his sale of 'Yorkshire
" 'Relish' and he said that by law the defendants were

"entitled to do so, for the only right which the plaintiff "had was that no one should sell his sauce as the sauce "of the plaintiff and that what the defendants were "doing was to trade, not in Goodall, Backhouse & Co.'s "'Yorkshire Relish,' but in Holbrook's 'Yorkshire "'Relish,' and thus to do a service to the public."

At page 90 the same Lord Justice says:—

"Suppose that the words 'Yorkshire Relish' have "obtained such a significance in the market that it is "impossible, either by dressing them up or by coupling "them with other words to render them innocuous and "incapable of misleading buyers, what then? Are the "defendants entitled to take and use this old, well-known "fancy name denoting the plaintiff's goods, and thereby "filch from the plaintiff his old-established trade; or "must they leave the fancy name alone? This, in my "judgment, is the point in case. Mr. Moulton says "even so the defendant's may take the name, but I am "of opinion that this is not so, and that they must leave "the name alone if they cannot render it otherwise than "misleading to purchasers. It may be that the result "of such a state of things is that it gives the plaintiff "a practical monopoly in the words which otherwise he "would not have, and, it appears to me, so far as the "evidence in the present case goes, that this is so. "Whether it is possible to mask the words 'Yorkshire "'Relish' so that they will become innocuous, such as "by selling 'Yorkshire Relish" in jars or tins or barrels, "I do not know; but it would seem that if this be "possible, and it can be done so that the words do not "mislead, then the object which I have no doubt the "defendants have in using the words will be thereby frus-"trated. It is said that this puts the plaintiff in the same "position as if he had a registered trade mark or a "patent unexpired, but this point was dealt with by "three of the learned Lords in the House of Lords in "the *Stone Ale case*."

Montgomery v. *Thompson.*

The opinion closes as follows: "Since writing this "judgment the case of *Reddaway* v. *Banham* has been

"decided in the House of Lords. It is an *a fortiori* "case to the present, for in *Reddaway* v. *Banham* the "words 'Camel-hair Belting' were admitted to be de- "scriptive of the article sold, and not a mere fancy name "given to an article by which it has become known to "the public; and yet it was held that a rival in trade "could not use the name if by so doing he represented "his goods as the goods of another."

In the above *Yorkshire Relish case* the injunction was granted by the Court below restraining the defendant from using the name "Yorkshire Relish," unless it should do it in such a way as to plainly show that it was a compound different from the plaintiff's. The defendant appealed on the ground that it would be impossible for it to do so and use the name "Yorkshire Relish" at all, thereby giving to the plaintiff a monopoly in the name after it had been decided that he had no trade mark in that name. The discussion in the Court of Appeals by the different Judges grew out of this contention on the part of the defendant that he could not use the words "Yorkshire Relish" at all under the injunction granted by the lower court. It seems very clear that if the lower court had enjoined the use of the words "Yorkshire Relish" altogether as applied to a sauce of the kind manufactured by the plaintiff, the Court of Appeals would have sustained the judgment.

The most important case probably before any of the Circuit Courts involving the questions at issue here is that of

Pillsbury-Washburn Flour Mills Co. v. *Eagle*, 86 Fed. R. 608.

In a very elaborate opinion the Court discusses many of the authorities already cited by us. We specially refer to pages 615, 616, 617, and following. On page 620 the decision of the Court in the Improved Fig Syrup Co. is cited as an authority. Reference is made to the discussion of the *Cigarette case* on page 621, to the "*Anatolia*" *Licorice case* at page 636, where "Anatolia," a geographical name, was protected by the Court of Chancery in England. "Anatolia was the name "applied to a whole tract of country wherein licorice-"root is largely grown. At the time plaintiff began to "use the word there was no other manufacturer of "licorice stamping it with this word. Subsequently, in "response to an order for 'Anatolia' licorice, defendants "caused a stamp to be prepared containing the word "'Anatolia' and put it on the goods, and afterwards con-"tinued to use it." The court below granted a preliminary injunction restraining the use of the word "Anatolia" by the defendants on licorice. In response to the argument that the word "Anatolia" was common to all, the Court said: "That argument is merely a "repitition of the fallacy which I have frequently had "occasion to expose. The property in the word for all "purposes cannot exist, but property in that word, as "applied by way of stamp upon a particular vendible "article as a stick of licorice, does exist the moment "the article goes into the market so stamped and there "obtains acceptance and reputation, whereby the stamp "gets currency as an indication of superior quality, or "some other circumstance which renders the article so "stamped acceptable to the public."

The case of *California Fig Syrup Co.* v. *Improved Fig Syrup Co.*, 51 Fed. 296, was more in line with the foregoing decisions, than appears from the report, for in that case, though the first carton used was a close reproduction of complainants, yet the second one, the use of which was enjoined, was entirely different except as to size and name. The color was specially distinguishable; the complainants carton was a yellowish white, the defendants, red. The injunction in the case at bar was copied verbatim from the injunction in that case merely making necessary changes of names.

The *Pillsbury-Washburn Flour Mills Case*, in 86 Fed. R., already cited, refers to many authorities, in addition to those herein referred to. In

Rawlinson v. *Brainard*, 59 N. Y. Supplement, 830, the Court decided: "A manufacturer may adopt as a "trade-mark a new combination of words which up to "that time had no significance attached to them in the "trade in which they are used, . . . although they may "be suggestive of the general nature of the article to "which they are applied."

In

Bass v. *Feigenspan*, 96 Fed. 206,

the learned Judge said: "Courts should not be astute "to recognize in favor of an infringer fine distinctions "between different articles of merchandise of the same "general nature, and should resolve against the wrong-"doer any fair doubt whether the public may or may "not be deceived through the application of the spurious "symbol."

In none of these cases we have cited did the plaintiff

have a trade mark in the name sought to be protected. But in every one of them the Court enjoined the defendant from using the name because, to permit him to do so, would enable him to sell his goods as the goods of plaintiff.

PETITIONER'S BRIEF.

It is argued in the brief that the decree is erroneous because it awards an accounting. If the decree in that respect is erroneous, it is too late now for the appellant to take advantage of it in this Court, because, that fact was not assigned as error. (See pp. 586 to 589).

By looking at the order allowing an appeal and approving the bond (p. 590), it will be seen that it was upon the assignment of errors the appeal was allowed. There has been no appeal allowed from what is now claimed as an additional error of the court below. We shall therefore not investigate the correctness of counsel's contention; but we now declare that if at any time it appears by motion in the court below that the judgment is not in proper form in the respect named, we will stipulate to a modification of the judgment.

It is certain that the judgment is in the usual, customary form.

The appellant's brief has many incorrect statements and arguments deduced therefrom.

For example:

1. It is asserted over and over again that we claim a trade-mark in the name "Syrup of Figs." That claim has not at any time been made in the court below. It was not necessary to make such a claim in order to attain the relief sought, and we did not make it.

2. The statement is made in the brief that less than one-tenth of one per cent. of fig substance is in the medicine, and an elaborate argument is made upon that hypothesis. Counsel omit to say that the record here shows the use of ten times as much. They argue from the evidence in the Stearns case, 73 Fed. Rep., and assume that such is the testimony here. In fact they so state, see p. 12. They even cite at p. 12 the record at pp. 92 and 93 as supporting the statement. Read pp. 92, 93, 94, 95, 96, 97.

3. Great reliance is placed in the brief upon the evidence of George Alt. But Alt was completely discredited, pp. 501, 502, 461 *et seq.*, 565 *et seq.*, 448 *et seq.* See his cross examination, p. 352 *et seq.* He was discredited in this case and he was discredited as to his affidavit filed in the Improved Fig Syrup case before Judge McKenna, see record, p. 264. 51 Fed. R., 296.

4. Again it is stated repeatedly in the brief that from the beginning, "in 1878, up to the year 1896, a period " of eighteen years, Mr. Queen and his Company adver- " tised and stated on his labels that the preparation was " a California Liquid Fruit Remedy," etc., etc.

The quotation is from pp. 45 and 46. In the foregoing brief we have cited the record to show that it was not until 1889 that these statements were made.

5. At p. 58 counsel say the words on the label, they mean the carton, that "the juice of the fig in the com- " bination is to promote the pleasant taste, is printed in " very small and almost illegible type. Unless a person has " unusually good eye-sight he would need the aid of a " magnifying glass to decipher it." The same statement

was made in the court below. Our reply there was to ask the court to look at the carton. We make the same reply here.

6. At p. 88 the assertion is made that the Circuit Court of Appeals of the Ninth Circuit did not in 54 Fed., 175, pass on the question of fraud on the part of plaintiff. That was the principal question there as it is here and substantially same arguments *pro* and *con* were made there that are made here. The same arguments were made before McKenna Circuit Judge.

The foregoing are samples of the inaccuracies.

Judging from recollection and the hasty examination (none other has been possible in the time) of the authorities cited by appellant, we think a discussion of them is not necessary.

We conclude our argument by earnestly, but respectfully urging, that the plainest dictates of justice, as between man and man, and as between the citizen seeking the protection of the Courts, and the Courts organized and maintained for the purpose of giving that protection, require the judgment of the Court below to be affirmed. In such action, this Court will find support in a long line of decisions, rendered by men who have honored the judiciary of this country and of England.

Respectfully submitted,

WARREN OLNEY,
For Respondent.

J. G. CARLISLE,
Of Counsel.

Supreme Court of the United States.

No. 36.—October Term, 1902.

Clinton E. Worden & Company, Petitioner, *vs.* The California Fig Syrup Company, Respondent.	On writ of certiorari to the United States Circuit Court of Appeals for the Ninth Circuit.

[January 5, 1903.]

On June 1, 1897, the California Fig Syrup Company, created under the laws of the State of Nevada, and having its principal place of business in San Francisco, California, filed a bill in equity in the Circuit Court of the United States for the Northern District of California, against Clinton E. Worden & Company, a corporation of the State of California, and against J. A. Bright, T. F. Bacon, C. J. Schmelz and Lucius Little, citizens of the State of California.

The bill alleged that, in the year 1879, one Richard E. Queen invented "a certain medical preparation or remedy for constipation and to act upon the kidneys, liver, stomach and bowels, which medical compound is a combination in solution of plants known to be beneficial to the human system, forming an agreeable and effective laxative to cure habitual constipation and many ills, depending upon a weak and inactive condition of the liver, kidneys, stomach and bowels;" that shortly after the said invention the said Queen sold and transferred all his right, title and interest in and to said medical compound, and in and to the trade name, trade marks and good will of said company to the complainant company, which has ever since been engaged in the manufacture and sale of said medical preparation or remedy; that said medical preparation has always been marked, named and called by the complainant "Syrup of Figs," that name being printed or otherwise marked upon every bottle, and also printed upon the boxes, packages or wrappers in which the bottles of the preparation were packed for shipment and sale; that the complainant and its said predecessor in interest were the first to pack and dress or mark a liquid laxative preparation in the manner illustrated by Exhibits "A" and "B" attached to the bill—that is to say, in an oblong, rectangular box or carton, with statements of the virtues of the preparation printed in different languages upon the back and sides of the carton, and on the border within which, at the top, is a representation of a branch of a fig tree, bearing fruit and leaves, surrounded by the words "Fig Syrup Company," or